APR 24 1924
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SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1923.

No. 261.

THE UNITED STATES OF AMERICA *EX RELATIONE* THE BALDWIN COMPANY, APPELLANT,

vs.

THOMAS E. ROBERTSON, AS COMMISSIONER OF PATENTS; E. S. HOWARD COMPANY, INTERVENING DEFENDANT.

ON APPEAL FROM THE COURT OF APPEALS OF THE DISTRICT OF COLUMBIA.

ALSO

ON APPLICATION FOR WRIT OF CERTIORARI TO SAID COURT OF APPEALS.

BRIEF FOR APPELLANT.

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vs.

THOMAS E. ROBERTSON, AS COMMISSIONER OF PATENTS; R. S. HOWARD COMPANY, INTERVENING DEFENDANT.

ON APPEAL FROM THE COURT OF APPEALS OF THE DISTRICT OF COLUMBIA,

ALSO

ON APPLICATION FOR WRIT OF CERTIORARI TO SAID COURT OF APPEALS.

BRIEF FOR APPELLANT.

GENERAL STATEMENT OF CASE.

In essence the controversy here presented arises under the trade-mark law of the United States and

revolves about the differing contentions of The Baldwin Company as owner of two certain registered trade-marks used by it to mark and identify pianos of its manufacture shipped and sold in interstate and foreign commerce, and of R. S. Howard Company, who insists that said trade-marks were improperly admitted to registry and has applied to the Commissioner of Patents to cancel same.

The Commissioner of Patents, acting upon the facts and his understanding of the provisions of applicable law, declined to cancel either of the marks in controversy, but upon appeal to the Court of Appeals of the District of Columbia the decision of the Commissioner of Patents was reversed and the Clerk of that Court was directed "to certify these proceedings (to the Commissioner) as by law required."

48 D. C. Apps. 437.

On application of The Baldwin Company, an appeal to this Court was granted and subsequently it also filed here an application for certiorari. Upon consideration, this Court, being of opinion that the decision of the Court of Appeals of the District of Columbia was "in no sense a final judgment reviewable here upon writ of certiorari or appeal," denied application for the former and dismissed the latter.

Mr. Justice Day, speaking for the Court, stated the case as it then was and the conclusions of the

Court with respect thereto as follows (256 U. S. 35, 36):

> "The Commissioner of Patents refused to cancel the certificates of registration of a trade-mark consisting of the word 'Howard' registered by the Baldwin Company, October 17, 1905, and made a like ruling refusing to cancel the certificate of registration of the word 'Howard' arranged in monogram with the initials 'V. G. P. Co.' registered March 8, 1898, which marks were registered as trade-marks for pianos. The appeals were heard together in the District Court of Appeals upon the appeal of the Howard Company.
>
> "Proceedings were brought in the Patent Office by the Howard Company against the Baldwin Company to cancel the certificates of registration. It appears that a suit was begun in the District Court of the United States for the Southern District of New York by the Baldwin Company against the Howard Company while the cancellation proceedings were pending, which resulted in a decree in favor of the Baldwin Company restraining the Howard Company from making or selling pianos bearing the word 'Howard,' but permitting it to use the marks 'R. S. Howard Company' and 'Robert S. Howard Company.' 233 Fed. Rep. 439. This decree was affirmed by the Circuit Court of Appeals for the Second Circuit. 238 Fed. Rep. 154."
>
> "The Baldwin Company filed in the Patent Office a certified copy of the record in

the federal courts in New York, and in the Patent Office the Examiner of Interferences and the Commissioner of Patents, on appeal to him, held that the adjudication in the New York courts was a bar to the claim of the R. S. Howard Company to cancel the certificates of registration of the trade-mark 'Howard,' and dismissed the petition of the Howard Company; thereupon, appeal was taken from the decision of the Commissioner to the Court of Appeals of the District. That court reversed the decision of the Commissioner of Patents, and directed the clerk to certify its decision as required by law.

"The application in the Patent Office to cancel the trade-marks was under Sec. 13 of the Trade-Mark Act of February 20, 1905, c. 592, 33 Stat. 728, which provides:

" 'SEC. 13. That whenever any person shall deem himself injured by the registration of a trade-mark in the Patent Office he may at any time apply to the Commissioner of Patents to cancel the registration thereof. The Commissioner shall refer such application to the examiner in charge of interferences, who is empowered to hear and determine this question and who shall give notice thereof to the registrant. If it appear after a hearing before the examiner that the registrant was not entitled to the use of the mark at the date of his application for registration thereof, or that the mark is not used by the registrant, or has been abandoned, and the examiner shall so decide, the

Commissioner shall cancel the registration. Appeal may be taken to the Commissioner in person from the decision of examiner of interferences.'

"The appeal from the decision of the Commissioner to the Court of Appeals of the District was under Sec. 9 of the act, which provides:

" 'SEC. 9. That if an applicant for registration of a trade-mark, or a party to an interference as to a trade-mark, or a party who has filed opposition to the registration of a trade-mark, or party to an application for the cancellation of the registration of a trade-mark, is dissatisfied with the decision of the Commissioner of Patents, he may appeal to the Court of Appeals of the District of Columbia, on complying with the conditions required in case of an appeal from the decision of the Commissioner by an applicant for patent, or a party to an interference as to an invention, and the same rules of practice and procedure shall govern in every stage of such proceedings, as far as the same may be applicable.'

"A motion is made to dismiss the appeal. No specific provision is made for an appeal from the decision of the District of Columbia Court of Appeals reviewing the decision of the Commissioner of Patents, but the decision is to be certified to the Commissioner to govern further proceedings in the case. Section 4914, Rev. Stats.; 8 U. S. Comp. Stats., Sec. 9459.

"If the decision of the Court of Appeals

of the District of Columbia is not final, then the motion to dismiss the appeal should be sustained, and we have no authority to grant a writ of certiorari. Judicial Code, Secs. 250, 251.

"The nature of proceedings of the character now under consideration was considered in FRASCH *v.* MOORE, 211 U. S. 1, in which the opinion of Chief Justice Alvey, speaking for the Court of Appeals of the District of Columbia in ROUSSEAU *v.* BROWN, 21 App. D. C. 73, 80, explaining the nature of this statutory proceeding and affirming that it did not authorize a judgment but only the return by the Court of Appeals of a certificate to the Commissioner of Patents, to be there entered of record to govern further proceedings in the case, was fully approved.

"In ATKINS & Co. *v.* MOORE, 212 U. S. 285, application for registration of a trade-mark was refused by the Examiner, which action was approved by the Commissioner, and affirmed on appeal by the Court of Appeals of the District of Columbia, an appeal and writ of error were allowed, both of which were dismissed in this court. The previous decisions of this court were reviewed by Chief Justice Fuller, speaking for the court, and in concluding the opinion he said: 'In the light of the various details of the Act of February 20, 1905, and of the specific provisions of Sec. 9, we were of opinion (GAINES *v.* KNECHT, 212 U. S. 561) that proceedings under the act were governed by the same rules of practice and procedure as

in the instance of patents, and the writ of error was accordingly dismissed. The same result must follow in the present case. Under Sec. 4914 of the Revised Statutes no opinion or decision of the Court of Appeals on appeal from the Commissioner precludes 'any person interested from the right to contest the validity of such patent in any court wherein the same may be called in question,' and by Sec. 4915 a remedy by bill in equity is given where a patent is refused, and we regard these provisions as applicable in trade-mark cases under Sec. 9 of the Act of February 20, 1905.'

"We are of opinion that the principle there announced controls this case. No provision is made which permits this statutory proceeding to be carried beyond the decision of the Court of Appeals of the District of Columbia, the decision of which court is directed to be certified to the Commissioner of Patents. It is in no sense a final judgment reviewable here upon writ of certiorari or appeal. * * *

"It follows that the appeal must be dismissed, and the petition for a writ of certiorari denied."

This opinion was delivered April 11, 1921, and within thirty (30) days thereafter, that is on May 7th, 1921 (R. 11, 71), The Baldwin Company filed and served upon the defendant Robertson, Commissioner of Patents, its original verified bill of complaint in the present case and on May 17, 1917, rule to show cause why a writ of injunction should

not be issued restraining and enjoining said defendant Robertson from cancelling the trade-mark registrations in question was issued (R. 11).

Basis for instituting this action in equity is found in the provisions of section 9 of the Trade-mark Act in connection with section 4915 of the Revised Statutes U. S. as construed in BALDWIN Co. *v.* HOWARD Co., 256 U. S. 35, *supra,* and the cases therein cited. Since institution of this suit and its disposition by the Court of Appeals of the District of Columbia, this Court has announced its opinion and decree in AMERICAN STEEL FOUNDRIES *v.* ROBERTSON, COMMISSIONER OF PATENTS *et al.*, 262 U. S. 209, to which reference is made as a strongly supporting authority.

Defendant Robertson as Commissioner of Patents, by way of showing cause, answered, admitting all pertinent averments of fact set forth in The Baldwin Company's bill of complaint, but asserted that his further official action in the premises was to be controlled solely by the conclusions expressed by the Court of Appeals of the District of Columbia as certified to him by the Clerk of said Court, same being set forth and reported in 48th Apps., D. C., 437 *et seq.,* and therefore he prayed that the injunction *pendente lite* asked by plaintiff, The Baldwin Company, be denied and the bill of complaint be dismissed (R. 11-12).

May 17, 1921, before further action had been had in the trial court, R. S. Howard Company filed its petition for leave to intervene in the cause as a party defendant (R. 70). Its petition in such regard was granted May 27th, 1921, and on the same day it filed answer to plaintiff's bill of complaint, contending, among other things, that under the circumstances set forth in and by said bill of complaint the Supreme Court of the District of Columbia was without jurisdiction to grant the relief prayed therein or any thereof, and asked that said bill of complaint be dismissed.

Thus the litigation stood until October 13th, 1921, when plaintiff, The Baldwin Co., filed its amended bill of complaint, naming both the original defendant, Robertson, Commissioner of Patents, and the intervener, R. S. Howard Company, as parties defendant and somewhat amplifying the allegations of its original bill. It averred its ownership of the registered trade-marks numbered, respectively, 31,411, dated March 8th, 1898, consisting of the word—Howard—accompanied by the initials V. G. P. Co. arranged in a monogram, and 46,993 dated October 17th, 1905, consisting of the word—Howard— standing alone, the word—Howard—in both instances "being written or impressed in a particular and distinctive manner, that is, in old English letters"; the continuous use of each of said trade-marks in its business of manufac-

turing and selling pianos in interstate and foreign commerce, and the broad and valuable good will which had been built up in connection with such use; its exclusive and legal right to appropriate and use said trade-marks; the proceedings in the United States District Court for the Southern District of New York and in the Circuit Court of Appeals for the Second Circuit, to which R. S. Howard Company was a party and which had eventuated in a decree to effect

> "That the name 'Howard' without prefix or suffix, on pianos, or contained in advertisements or otherwise used in connection with pianos, indicates that the pianos bearing or referred to by said name, are the product of the plaintiff, the Baldwin Company" and that the plaintiff the Baldwin Company alone was "entitled to use the word 'Howard' without prefix or suffix in the name of any company, firm or corporation that manufactures pianos bearing said name"

and enjoining any infringement of such exclusive right of user (R. 5); the orders of the examiner of interferences affirmed by the Commissioner of Patents dismissing R. S. Howard Company's applications for cancellation of said trade-marks (R. 6); the proceedings subsequently had in the Court of Appeals of the District of Columbia, and the absence of possibility of any damage to R. S. Howard Company from the continued registration of rec-

ord of trade-marks (R. 7); that the Baldwin Company had obtained registration of said trade-mark 'Howard' in numerous foreign countries based alone on the registration of said mark in the United States Patent Office, and that cancellation of such registration in said Patent Office would cause the cancellation of such registrations in such foreign countries, so that the foreign business of plaintiff, which is largely based upon such foreign registrations of its trade-marks, "would be seriously threatened and greatly and irreparably injured by the cancellation of either or both of said trade-marks in the United States Patent Office" (R. 8); that plaintiff is possessed of a vested property interest and right in the continued maintenance of said registrations of record in the United States Patent Office, and that in the circumstances narrated the cancellation of such registrations "would constitute a deprivation of plaintiff's property without due process of law, contrary to the provisions of the Fifth Article of Amendment to the Constitution of the United States (R. 9), and prayed that the defendant Robertson be enjoined from cancelling such registrations, and that R. S. Howard Company, intervener, be decreed to be without any such right or interest in the word "Howard" standing alone, without prefix or suffix, as is requisite to enable it to carry on proceedings for cancellation of said trade-marks, and for general relief (R. 10).

On October 13, 1921, intervener, R. S. Howard Company, filed an elaborate answer to plaintiff's amended bill of complaint (R. 12-66), and on the same day filed separate motion to dismiss said bill upon the ground—among others not now important—that the Supreme Court of the District of Columbia was "without power or authority to grant the relief prayed for, or any relief in the premises (R. 66).

The Baldwin Company's application for preliminary injunction and R. S. Howard Company's motion to dismiss plaintiff's amended bill of complaint were brought on for hearing at one and the same time before Hoehling, Associate Justice. Defendant, the Commissioner of Patents, submitted to "such action as the court may deem proper" agreeing, in open court, "that, pending the determination of the application for preliminary injunction and motion to dismiss, the status of the registration of the trade-marks would be preserved unimpaired, so far as the Patent Office is concerned" (R. 71).

After hearing full argument, the learned trial Justice on February 20th, 1922, first having stated the previous history of the controversy between the parties and the disposition thereof made by this Court in Baldwin Co. *v.* Howard Co., 256 U. S., 35, continued and concluded as follows (R. 72):

> "In view of the holding of the Supreme Court of the United States, *supra*, to the effect that the decisions of the Court of Ap-

peals of this District, both in patent and trade-mark cases, are in no sense a final judgment reviewable upon certiorari or appeal, but are only the return by that court of a certificate to the Commissioner of Patents to be there entered of record to govern further proceedings in the case; in view of the further holding of said Supreme Court that Secs. 49[illegible] and 4915 R. S., U. S., are applicable in trade-mark cases; and, finally, in view of the express holding of the Supreme Court that this case is controlled by the principles so announced; the conclusion seems necessarily to follow that the Supreme Court, having before it an application to review the adverse holding of the Court of Appeals, *supra*, and finding itself without jurisdiction to entertain the same, either on appeal or by certiorari; nevertheless, in direct and express terms and language, pointed out a method and way in which such judicial review of the questions might be secured.

If that be not the true intent and meaning of the decision of that court, then the language of the opinion must be denied its ordinary, plain, and usual meaning.

If, therefore, there be open to the plaintiff, Baldwin Co., an opportunity for judicial review of the questions raised in this suit, under said Sections 4914 and 4915 R. S., U. S., and the Supreme Court apparently has so held; then pending the proceeding, the status of the subject-matter of the litigation should be preserved unimpaired; since

the remedy so given would be futile if, pending the proceeding, the trade-mark registrations be permitted to be canceled.

Accordingly, the court is of opinion that the motion of defendant, Howard Co., to dismiss should be overruled, and that the application of plaintiff, Baldwin Co., for preliminary injunction should be granted. Appropriate order in that behalf may be prepared by counsel and submitted, upon due notice.

As the case now stands on the pleadings, the rule to show cause was issued upon the original bill of complaint, answer to which original bill was made and filed by said defendant, Howard Co. The court has deemed it proper to consider that answer in connection with the application for preliminary injunction which was carried forward in the amended bill of complaint.

The motion to dismiss the cause, however, was filed in response to the amended bill of complaint, and which latter supersedes and takes the place of the original bill. Hence, the motion to dismiss must be and has been determined upon the allegations of said amended bill, and the matters of law urged in opposition thereto."

It was accordingly decreed (R. 73):

"(1) That the motion of intervener-defendant, R. S. Howard Company, to dismiss plaintiff's bill of complaint herein both as filed and as amended be, and same is hereby denied;

> (2) That pending final disposition of this cause, defendant Thomas E. Robertson, Commissioner of Patents, his assistants, agents, subordinates and successors be and they are and each of them is hereby restrained and enjoined from cancelling or erasing from the records of the United States Patent Office or in any other manner interfering with the registration in said United States Patent Office of the two several trade-marks described in said bill of complaint."

To review that decree, R. S. Howard Company and the Commissioner of Patents each prayed and perfected general appeals to the Court of Appeals of the District of Columbia, but the case was heard by the Court of Appeals as on "special appeal" (27 Stats. 436) by the R. S. Howard Company (R. 79).

It is said in the opinion of the Court of Appeals (Smyth, Ch. J., speaking for the majority):

> "The case turns upon the jurisdiction of the Supreme Court of the District to entertain the suit. Registration of trade-marks, opposition to registration, cancellation of registration, and interference proceedings are all governed by statute (33 Stat., sec. 724, *et seq.*). The solution of any question which arises with respect to these matters must be in harmony with the terms of the statute (citing cases). If there is no statutory authority for bringing the suit, then the

> action of the lower court must be reversed and the amended bill dismissed" (R. 79, *et seq.*).

After discussing at some length the relative characteristics of letters patent and trade-marks under the United States statutes and the existence or absence of "property right" in one and the other, and after reviewing the opinions of this court in ATKINS & Co. *v.* MOORE, and BALDWIN Co. *v.* HOWARD Co., *ubi supra*, the learned chief justice concludes discussion with the statement that (R., 83)

> "The court (Supreme Court U. S.) had no occasion to determine whether section 4915 gave a defeated applicant for registration the right to commence a proceeding in equity, and we do not think it intended to so decide. In this we are supported by a statement in the last opinion of the court upon the subject. BALDWIN Co. *vs.* HOWARD Co., *supra*. Mr. Justice Day, who spoke for the court in that case, after referring to the decisions in the Frasch, Atkins, and Gaines cases, wherein the various statutory sections about which we have been writing were referred to, said: 'No provision is made which permits this statutory proceeding to be carried beyond the decision of the Court of Appeals of the District of Columbia, the decision of which court is directed to be certified to the Commissioner of Patents.' The statutory proceeding referred to is the one relating to the registration of trade-marks, the decisions of the Commissioner touching the

same, and the review of his decisions by this court. This proceeding, according to the learned justice, cannot be carried beyond the decision of the Court of Appeals. In other words, the questions of registration, cancellation, opposition, and interference in trade-mark cases are ended by our decision. The only thing decided in such a proceeding is as to whether or not the mark shall be registered, or, having been registered, whether or not it shall be cancelled. The effect of the registration, as we have seen, is simply to provide a rule of evidence which under section 16, *supra*, casts upon him who would attack the right of the registrant to the mark the burden of establishing his claim in an infringement, unfair competition, or other proper proceeding. We think the court had this in mind when it said that there was no authority for carrying the statutory proceeding beyond the decision of the Court of Appeals.

Believing that there is no authority for the maintenance of this suit we reverse the decision appealed from and remand the case with instructions to dismiss the suit, costs to be assessed against appellee."

From this conclusion, as well as from the reasoning of the majority upon which it was based, Mr. Justice Robb dissented, saying in part (R. 84):

* * * "Were this an open question, the force of the argument of my Associates would lead me to their conclusion that the provision last quoted refers only to proceed-

> ings in this court, and that view would be further strengthened by the specific provisions of Section 22 of the Trademark Act, which apparently were intended to restrict and limit the right to equitable relief to parties to 'interfering registered trademarks.' However, as I read the opinion of the court in BALDWIN Co. *vs.* HOWARD Co., 256 U. S. 35, 39, it there is intimated that Section 4915 R. S. authorizes a remedy by bill in equity in a case like the present. Therefore, while it is quite possible that, when the provisions of Section 22 of the Trade-mark Act are brought to the attention of the Supreme Court and a definite ruling invoked, the conclusion reached by my associates will be approved, I now feel constrained to give full force and effect to the suggestion in the Howard case and to dissent here."

Pursuant to the conclusions of the Court of Appeals as expressed by its majority members, the decree of the Supreme Court of the District of Columbia overruling (February 5, 1923) R. S. Howard Company's motion to dismiss and granting plaintiff's application for an injunction *pendente lite* was reversed with costs, and the cause was "remanded to said Supreme Court with instructions to dismiss the suit" (R. 84).

The jurisdiction of the Supreme Court of the District of Columbia to entertain this suit in any

aspect or at all, and also the construction of Sec. 9 of the Trade-mark Act in association with Sec. 4915 R. S. U. S. (one of the patent laws), both having been put in issue by defendant's motion to dismiss plaintiff's amended bill of complaint, and said motion to dismiss having been granted because of want of jurisdiction on part of Supreme Court of the District of Columbia in the premises, The Baldwin Company prayed for and was allowed appeal (R. 85) to this Court to review said decree of the Court of Appeals (Sec. 250 Jud. Code), which was allowed (R. 87) and duly perfected (R. 87-89).

In its primary and substantial aspect The Baldwin Company's suit is an assertion of vested property rights under the Trade-mark Statute and the Due Process clause of the Fifth Amendment of the Federal Constitution. The enforcement of such rights so asserted is attempted, in part at least, by invoking supposedly applicable provisions of Section 4915 of the Revised Statutes of the United States, which section, on its face and as written, is a "Patent law" of the United States.

Jurisdiction of the Supreme Court of the District of Columbia to entertain any such suit to enforce any such rights is denied by the R. S. Howard Company and its denial has been upheld by the Court of Appeals of the District of Columbia.

Such combination of written law and circumstantial facts has seemed to us to require considera-

tion of an exception to the general right of appeal granted in Section 250 of the Judicial Code, under which the appeal to this Court was prayed and allowed. That exception reads,

> "The judgments and decrees of said Court of Appeals (of the District of Columbia) shall be final in all cases arising under the patent laws * * * and except as herein provided in the next succeeding section (that is Sec. 251) the judgments and decrees of said Court of Appeals shall be final in all cases not reviewable as hereinbefore provided."

In connection with the exception so expressed it is also to be noted that Section 18 of the Trademark Act of February 20th, 1905, as amended (33 Stats. 724, 729), similarly provides

> "That writs of certiorari may be granted by the Supreme Court of the United States for the review of cases arising under *this Act* in the same manner as provided for patent cases by the Act creating the Circuit Court of Appeals."

In view of the doubt so engendered as to whether review by this Court of the decree of the Court of Appeals of the District of Columbia in the instant cause should be sought by way of appeal or certiorari, The Baldwin Company, on April 25th, 1923, well within the time limited by the provisions of the Act of September 6th, 1916, filed in this Court

its petition for certiorari, and submitted same to the Court as required by its Rules of Practice, on May 21st, 1923, and the same is still held *sub judice,* final disposition having been postponed to this hearing of the case on its merits.

Because of the expressions used and declarations made by this honorable Court in

> Hutchinson, Pierce & Co. *v.* Loewy, 217 U. S. 457, 460, 461;
> Street & Smith *v.* Atlas Mfg. Co., 231 U. S. 348, 352;
> Chott *v.* Ewing, 237 U. S. 197, 199-202;

it may appear that in cases such as here at bar certiorari rather than appeal may be the preferred method for which to seek review of decrees of the Court of Appeals of the District of Columbia as well as of the United States Circuit Courts of Appeal located in the several Circuits.

Assignment of Errors.

The Baldwin Company duly assigned errors (R. 87) as follows:

> "1. Error on part of the Court of Appeals of the District of Columbia in holding that the Supreme Court of the District of Columbia was without jurisdiction to entertain this suit.

"2. Error on part of the Court of Appeals of the District of Columbia in reversing the decision and order of the Supreme Court of the District of Columbia, appealed from, for want of jurisdiction and remanding the cause with directions to dismiss plaintiff's bill of complaint with costs."

ARGUMENT.

Since announcement of the decision of the learned Court of Appeals in the case at bar this honorable Court again has had occasion to consider the jurisdiction of the District Courts of the United States under Sec. 4915, R. S. U. S., to entertain bills of complaint brought by a defeated party for registration of trade-marks, and, following its earlier decisions in Gandy *v.* Marble, 122 U. S. 285, and Baldwin Co. *v.* Howard Co., 256 U. S. 35, it again has declared that all such courts have jurisdiction of suits in equity brought against the Commissioner of Patents and an intervening party (as here R. S. Howard Co.) to determine such plaintiff's right to have trade-mark registered. American Steel Foundries *v.* Robertson, Commissioner, &c., 262 U. S. 209. In that case the plaintiff, American Steel Foundries, had filed application in the Patent Office for registration of its trade-mark "Simplex," which was refused by the Examiner of Interferences and such action was affirmed by the Commission. On appeal to the Court of Appeals of the District of Columbia the rejection by

Patent Office officials was affirmed and the action of the court was certified to the Commissioner to govern the further proceedings in the cause as required by law. Application to this court for certiorari was granted and subsequently dismissed for lack of jurisdiction, on the ground that the decree of the Court of Appeals of the District of Columbia was not a final decree (American Steel Foundries *v.* Whitehead, Commissioner, 256 U. S. 40, 41). American Steel Foundries thereupon filed its bill in equity under Sec. 9 of the Trademark Act of February 20, 1905 (33 Stats. 724, ch. 592), and Section 4915 R. S. U. S. Simplex Electric Heating Company promptly intervened and filed a motion to dismiss the bill for lack of jurisdiction in the District Court "over the subject-matter or alleged cause of action," and that motion was granted by the District Court without opinion. From the decree of the District Court dismissing its said bill of complaint, American Steel Foundries, by direct *appeal,* brought its case to this Court, which, upon consideration, entertained the *appeal,* reversed the decree of the District Court, and remanded the case to that court for further proceedings, saying, in course of its opinion (per Mr. Chief Justice Taft), at page 212:

> "The question in this case is whether the closing words of § 9 'and the same rules of practice and procedure shall govern in every stage of such proceedings, as far as the same may be applicable,' are broad enough in

their scope to include the 'remedy by bill in equity' granted to unsuccessful applicants for a patent in § 4915.

"In GANDY *v.* MARBLE, 122 U. S. 432, an unsuccessful applicant for a patent who had carried his application by appeal to the Supreme Court of the District, which was dismissed on its merits January 30, 1880, on May 3, 1883, filed a bill in equity in the District Supreme Court under § 4915 against the Commissioner of Patents. That Court dismissed the bill on the ground that the applicant had failed to prosecute his application within two years after the dismissal of his appeal from the Commissioner by the Supreme Court of the District, basing it on § 4894 of the Revised Statutes, reading as follows:

" 'SEC. 4894. All applications for patents shall be completed and prepared for examination within two years after the filing of the application, and in default thereof, or upon failure of the applicant to prosecute the same within two years after any action therein, of which notice shall have been given to the applicant, they shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner of Patents that such delay was unavoidable.'

"This section applies to proceedings in the Patent Office and before the Commissioner, and it was pressed upon this Court that it could not apply to such an independent proceeding as the bill in equity provided for in § 4915. But this Court held

that § 4894 did apply. Mr. Justice Blatchford, speaking for the Court, admitted (p. 439), following BUTTERWORTH *v.* HOE, 112 U. S. 50, 61, that the proceeding by bill in equity, under § 4915 'intends a suit according to the ordinary course of equity practice and procedure, and is not a technical appeal from the Patent Office, nor confined to the case as made in the record of that office, but is prepared and heard upon all competent evidence adduced and upon the whole merits,' but continued, 'yet the proceeding is, in fact and necessarily, a part of the application for the patent.' He summed up the conclusion of the Court as follows (p. 440):

"'The presumption of abandonment, under § 4894, unless it is shown that the delay in prosecuting the application for two years and more after the last prior action, of which notice was given to the applicant, was unavoidable, exists as fully in regard to that branch of the application involved in the remedy by bill in equity as in regard to any other part of the application, whether so much of it as is strictly within the Patent Office, or so much of it as consists of an appeal to the Supreme Court of the District of Columbia under § 4911. The decision of the court on a bill in equity becomes, equally with the judgment of the Supreme Court of the District of Columbia on a direct appeal under § 4911, the decision of the Patent Office, and is to govern the action of the Commissioner. It is, therefore, clearly a

branch of the application for the patent, and to be governed by the rule as to laches and delay declared by § 4894 to be attendant upon the application.'

"This view of the intimate relation of the bill in equity allowed in § 4915 to the application for a patent and the practice and procedure provided in due course thereof is of much assistance in giving proper scope to the words of § 9 of the Trade Mark Act. After making provision for an appeal to the District Court of Appeals from a simple refusal of registration, and from decisions of the Patent Office in three different kinds of adversary proceedings therein in respect of such registration, on complying with the conditions required in case of an appeal from refusal of a patent or a decision in a patent interference proceeding, the words are 'and the same rules of practice and procedure shall govern in every state of such proceedings, as far as the same may be applicable.' If the bill in equity of § 4915 is only a part of the proceeding for an application for a patent as held in GANDY *v.* MARBLE, it is no straining of the language to make these words include a bill in equity for the registration of a trade-mark. This Court has taken exactly this view in ATKINS & CO. *v.* MOORE, 212 U. S. 285. In that case it was held that a decision of the Court of Appeals of the District of Columbia affirming the decision of the Commissioner of Patents refusing registration of a trade-mark on an appeal under § 9 of the Trade Mark Act was not a final judgment of the Court

of Appeals which could be appealed to this Court, and in the argument to show that it was not, Chief Justice Fuller, who spoke for the Court, said (p. 291):

"'Under § 4914 of the Revised Statutes no opinion or decision of the Court of Appeals on appeal from the Commissioner precludes "any person interested from the right to contest the validity of such patent in any court wherein the same may be called in question," and by § 4915 a remedy by bill in equity is given where a patent is refused, and we regard these provisions as applicable in trade-mark cases under § 9 of the Act of February 20, 1905.'

This language is quoted with approval in the opinion of this Court in BALDWIN Co. *v.* HOWARD Co., 256 U. S. 35, in which it was held that there could be no review in this Court, by appeal or certiorari, of a decision of the District Court of Appeals in respect to the registration of a trade-mark under § 9 of the Trade Mark Act.

It is pressed upon us, however, that this language in ATKINS & Co. *v.* MOORE and in BALDWIN Co. *v.* HOWARD COMPANY, was not necessary to the conclusion in those cases and is to be regarded as *obiter dictum*. It was used in *arguendo* and was the unanimous expression of the Court in both cases. It may be that the conclusion that the decision of the Court of Appeals was not final and appealable to this Court could have been reached without this argument; but, however this may be, the construction put by the Court on § 9 is most persuasive and fol-

lows so clearly from the decision in GANDY *v.* MARBLE, that we find no reason to question its correctness.

"An argument has been made to us against giving such an effect to § 9 based on the intrinsic differences between the nature of the patent right, and that in a trade-mark. We do not regard such differences as important in interpreting § 9 when it is obvious from that section and the whole of the Trade Mark Act that Congress intended to produce a parallelism in the mode of securing these two kinds of government monopoly from the Patent Office."

The Supreme Court of the District of Columbia is possessed of the same powers and exercises the same jurisdiction in all patent and trade-mark cases as the District Courts of the United States (Sec. 61, Code, D. C.), and the striking similarity in all matters, both of fact and law, in so far as matters of jurisdiction are concerned between the case at bar and the case above cited and extracted from is readily apparent.

In view of the Court's so recent and unanimous rejection of the argument based upon the *obiter dictum* theory and its deliberate reassertion of the view that its construction previously announced respecting Section 9 of the Trade-mark Act in connection with Sec. 4915, R. S., U. S., is not only persuasive, but also correct, and that in such connection not only are there no important differences between patent rights and trade-mark registra-

tions, but the Congress, by enacting Section 9 "and the whole of the Trade-mark Act, obviously intended to produce a parallelism in the mode of securing these two kinds of Government monopoly from the Patent Office," it would seem undesirable to further dwell upon the untenable character and quality of the arguments adduced by the learned Court of Appeals of the District of Columbia to effect that the statutory proceedings referred to in said Section 9 was not intended to embrace actions in equity under Section 4915, R. S. U. S.

However, in the course of the learned opinion of said Court of Appeals, it is suggested that Section 22 of the Trade-mark statute, which provides that

> "Whenever there are *interfering registered* trade-marks, any person interested in any one of them may have relief by suit in equity against the said registrant,"

calls for the application of the maxim "*Expressio unius est exclusio alterius.*" and the learned dissenting justice has intimated that, apart from certain other considerations mentioned, he would be disposed to accept such view and to "limit the right to equitable relief to parties to 'interfering registered trade-marks.' "

But said Section 22 of the Trade-mark Act forms an integral part of said Act and questions as to the general scope and effect of the Act were

being considered by the Court in the earlier as well as in the latest cited cases. It is hardly to be supposed that in reaching the conclusions expressed in its opinions announced in those cases that the Court was entirely oblivious to the presence and reasonably obvious effect of said Section 22.

But in addition to that said Section 22 differs in no important particular from Section 4918, R. S. U. S., which provides that

> "Whenever there are *interfering patents*, any person interested in any one of them * * * may have relief against the interfering patentee, and all parties interested under him, by suit in equity against the owners of the interfering patent; and the court, on notice to adverse party, and other due proceedings had according to the course of equity, may judge and declare either of the patents void in whole or in part * * * according to the interest of the parties in the patent or the invention patented." * * * (Itals. sup.)

The mere matching up of said Section 4918, R. S. U. S., with said Section 22 of the Trade-mark Act, and the consideration of the provisions of each in the light of the several cases above cited and relied upon, would seem to put at rest forever the suggestion that the provisions of Sec. 4915, R. S. U. S., are any the less applicable and potent in trade-mark because of the presence of said Section 22 than in patent applications.

The single difference of possible importance between the case at bar and Atkins *v.* Moore and American Steel Foundries *v.* Robertson lies in the circumstance that in the last-mentioned cases relief in equity was sought by defeated applicants for the registration of trade-marks, while in the case at bar the defeated applicant seeks to prevent the cancellation of record of trade-marks found to be entitled to registry and actually registered after due notice of the application therefor had been given to all the world, including the intervener at bar.

But this difference is of no real importance from the standpoint of jurisdiction, for Section 9 mentions *applicants for registration* of a trade-mark and *parties to an application for the cancellation* of such registrations in the same sentence and as upon the same footing, and this Court, noting that circumstance, remarked that

> "After making provision for an appeal to the District Court of Appeals from a simple refusal of registration, and from decisions of the Patent Office *in three different kinds of adversary proceedings therein in respect of such registration,* on complying with the conditions required in case of an appeal from refusal of a patent or a decision in a patent interference proceeding, the words are 'and the same rules of practice and procedure shall govern in every stage of such proceedings, as far as the same may be applicable.' If the bill in equity of Sec. 4915 is only part of the proceeding for an ap-

> plication for a patent as held in GANDY *v.* MARBLE, it is no straining of the language to make these words include a bill in equity for the registration of a trade-mark. This Court has taken exactly this view in ATKINS & Co. *v.* MOORE, 212 U. S. 285" (262 U. S. 209, 213-214).

In view of the statutory juxtaposition of the adversary proceedings provided in cases of applications for registration and applications for cancellation of registrations already made of record, does it require any straining either of language or the imagination to make the magic words at the end of Section 9 apply as well to the latter as to the former?

Is it not bordering upon the absurd to even suggest that the Congress was meticulously careful to protect possible rights, not even administratively admitted, in a mere applicant for registration, but deliberately denied all protection to the owner of an actually registered trade-mark with its attendant advantages and correlated statutory rights?

Cancellation of a mark solemnly admitted to registry after full compliance with statutory requirements and the exercise of the quasi-judicial function reposed in the Commissioner is of at least equal dignity and consequence with the rejection of an application to admit such a mark to registry. If mere refusal to register merits review in equity, why does not attempted cancellation justify and require at least equal consideration?

In GAINES *v.* KNECHT, 27 App. D. C. 530, 532, cited and extracted from by this Court (per Fuller, Chief Justice) in ATKINS *v.* MOORE, 212 U. S. 285, 290, wherein opposition to the registration of a trade-mark had been made upon the ground that the Act of February 20th, 1905, was unconstitutional, and "also that the applicant's mark was so similar to the mark of opponent that it would be likely to lead to confusion and enable applicant to perpetrate a fraud upon the public, the Court of Appeals, remarking that the Commissioner of Patents had "treated the statute as valid, and so he ought to have treated it until it is otherwise determined by the courts," proceeded as follows:

> "It may be true that the Commissioner acts in a judicial capacity, in determining whether the applicant is the owner of the trade-mark, and whether it is one of those marks the registration of which is prohibited, but when he has determined these in favor of the applicant, the act to be performed by him (namely, the act of registering the mark) is ministerial merely, * * *. Such judicial proceedings as there are, issue and culminate in a purely ministerial act—the mere registration of a mark which, if the statute is void, cannot possibly prejudice the right of the opponent or of anyone else. *It is not as if the culminating act interfered with the person or property of others.* * * * We think he did not err in treating the act as valid. When some case shall arise in which rights of person or property must be

> affected by the decision it will become necessary to consider the question now attempted to be raised; but to pass upon it now would be to decide a question of theory alone, and this is not the province of a court."

Whatever may be the quality of the act to be performed by the Commissioner of Patents under the advisory opinion of the Court of Appeals of this District—that is, whether it be quasi-judicial or purely administrative—it is certain that in the case at bar, if permitted to occur, it will inevitably interfere with and affect the rights "of person or property" vested, as we contend, by the lawful registration in 1898 and 1905 of the marks proposed to be cancelled, and the question distinctly reserved from decision in GAINES *v.* KNECHT (next above) would seem to have emerged.

That the Supreme Court of the District of Columbia and this Court, acting in the exercise of its appellate power, is amply endowed with authority to prevent infliction of any such a wrong is aptly illustrated by the opinion and decree of this Court in the case of NOBLE, Secretary, etc., *v.* UNION RIVER LOGGING RAILROAD CO., 147 U. S. 165, 171, and the numerous reported cases which have since cited that case with approval and relied upon the principles of right which it so ably expounds.

In this connection it is to be borne in mind that both the Examiner of Interferences and the Commissioner of Patents denied the application of R. S.

Howard Company for the cancellation of plaintiff's registrations upon the ground that as under the final decision of the Circuit Court of Appeals for the Second Circuit, The Baldwin Company had been found and held to have "used 'Howard' upon its pianos long prior to the time the R. S. Howard Company began business, and that such use was with the knowledge and consent of R. S. Howard personally" (R. 56), and, further, "that The Baldwin Company, the registrant and defendant herein, is entitled to use the word 'Howard' (*simpliciter*) upon the fall board of pianos, whereas the R. S. Howard Company, the petitioner herein, is restricted to the use of 'R. S. Howard,' 'Robert S. Howard' or 'R. S. Howard Company' (R. 55), no injury could occur to R. S. Howard Company by the continued registration of record by The Baldwin Company of its mark 'Howard' " (*simpliciter*).

On appeal from the Examiner of Interferences to the Commissioner of Patents, it was said by the latter:

> "It is well settled by a long line of decisions of the Court of Appeals of the District of Columbia that a party cannot sustain a cancellation proceeding unless he can establish that he is damaged by the registration of the mark. The rights of the parties to the use of the mark in this Country having been fully determined by the Court it is not seen how the rights of the R. S. Howard Company are in any way affected by the registration. No suit could be sustained

against the R. S. Howard Company for any use of the words 'R. S. Howard Company' or 'Robert S. Howard Company,' and it has no right to use the word 'Howard' alone.

"So far as the question of foreign registrations is concerned, there is no testimony that the R. S. Howard Company has in any way been interfered with in its trade in foreign countries where the pianos were marked with the name of the company, and they have under the Court decree no right to mark them otherwise. One of the witnesses testified that the trade of the agent of the R. S. Howard Company in Cuba would have been interfered with had the registration of the name 'Howard' in Cuba been affected by the Baldwin Company, but it does not appear whether that testimony was based upon the fact that at one time R. S. Howard had marked pianos with the word 'Howard' alone or not.

"The witness Barber testified that the registration of the word 'Howard' in certain South American countries might put an undue burden upon the R. S. Howard Company to sustain its right to sell pianos marked with the name of the company since it would be difficult to establish that the marks were not substantially the same.

"As pointed out by the Examiner of Interferences, however, the burden is upon the R. S. Howard Company to establish the injury and if goods marked with the name of the company had been held up or the importation prevented, it was encumbent upon the company to show it, which has not been done.

"It may be noted, as appears from the record and as stated in the decisions of both Courts, that the earlier registration was obtained with the full knowledge of R. S. Howard; that he made no objection to its registration and he made no objection to the use of the word 'Howard' by The Baldwin Company *for several years after he left its employ.* It is further to be noted that at one time a suit was brought in the Courts of New York by R. S. Howard to prevent the use of the word 'Howard' by The Baldwin Company, but this suit was withdrawn and The Baldwin Company continued to use the word 'Howard' for a number of years thereafter and built up a large trade without any objection on the part of R. S. Howard or the R. S. Howard Company until the cancellation proceeding was brought in 1914.

"Attention is called in the Brief to the following statement of the Commissioner rendered on a petition:

" 'It is urged that the R. S. Howard Company has not shown the injury required by the statute. But if the mark is not registrable, I think any one who is legitimately using the name "Howard" on pianos is injured by the registration sufficiently to warrant cancellation proceedings.'

"That decision was rendered before the decision in the suit and expressly states that the person who would be injured by the improper registration is one who was 'legitimately' using the name 'Howard' on pianos. But the Court proceedings determines that

the R. S. Howard Company has no right to use the word 'Howard.'

"It is urged that the name 'Howard' and the name 'R. S. Howard Company,' or 'Robert S. Howard Company,' are substantially the same, and therefore there would be likelihood of confusion. The best evidence, however, on this point is the fact that although The Baldwin Company has continuously used the word 'Howard' since a time prior to the organization of the R. S. Howard Company and the R. S. Howard Company has been in business since 1902, yet there is on the record no proof of any confusion.

"It must be held, therefore, that the petition for cancellation was properly dismissed.

"The decision of the Examiner of Interferences is affirmed." (R. 59, 60, 61.)

The learned Court of Appeals of the District of Columbia, in the course of its earlier opinion reversing the above decision of the Commissioner of Patents (R. 61), declared that "unquestionably The Baldwin Company was the first to make a trade-mark use of the word 'Howard,'" but held that this circumstance, strong as its claim to fair and equitable consideration would seem to be, was of no importance because "The mark (in question) is not only a common surname, *but the name of appellant corporation* (a mistaken statement, we submit), either of which is sufficient to prohibit the right of registration or to form the basis

of an action for cancellation." (Itals. Sup.) (R. 63.)

But the conclusion so expressed overlooks the finding of the New York courts that the use and registrations in question had been with the full knowledge and consent of R. S. Howard personally (R. 48, 50) and entirely ignores the second proviso of Section 5 of the Trade-mark Act of 1905, which authorizes registration of a mark consisting of "the name of an individual, firm, corporation or association" when "written, printed, impressed or woven in some particular or distinctive manner," as is averred to be the case with the marks in question (R. 53*j*, 53*k*, 53*l*, 53*m*, 53*n*, 53*p*, 53*q*, 53*r*, 53*s*).

Having acquiesced in the use of said mark "Howard" from 1896 (R. 47) and in its registration in the Patent Office by The Baldwin Company from 1905 on until 1914 (R. 50), when R. S. Howard Company, of which Robert S. Howard was the president, general manager, active executive head, and one of its largest stockholders (R. 24), filed in the United States Patent Office the applications for cancellation which lie at the foundation of the protracted and varied judicial proceedings which have since ensued and of which the instant proceeding is but an element; said Robert S. Howard would seem to have estopped himself by his conduct from now successfully seeking to destroy that which he knowingly permitted The Baldwin Company to create.

It is true that R. S. Howard Company is the record applicant for cancellation, and that it is R. S. Howard Company who claims and must establish its complaint of injuries to it resulting from the continued registration of "Howard." But it is certain that R. S. Howard Company has no basis of claim to or complaint of injury from such source that is not available to R. S. Howard, personally. Any course of conduct on his part which would give rise to estoppel against him personally would likewise serve to estop his creature. If he personally would be estopped by acquiescence from complaining of continued registration of "Howard," his company, upon which he conferred his name, given name as well as surname, would have no greater right for complaint, and even less basis of hope for relief.

From at least 1899 to 1914, some fifteen years. The Baldwin Company, with full knowledge on part of R. S. Howard, marked and sold pianos of its manufacture with "Howard" and built up a good will and sales trade in pianos so marked of more than one million dollars annually (R. 3).

In Old Lexington Club Distillery Co. *v.* Kentucky Distilleries and Warehouse Co., 234 Fed. R. 464, there had occurred an acquiescence of fifteen (15) years' duration in the use of a certain trademark before any steps were taken to enjoin such use or the making of remonstrance against it. In such circumstances objection was made by the user of the mark that the applicant should not be per-

mitted to register an interfering mark though older mark. The District Court (Haight, D. J.) sustained this contention in a well-considered and enlightening opinion, saying in part (p. 468):

> "I cannot see that this phase of the case can be distinguished on principle from the decision of the Circuit Court of Appeals of this circuit in PFLUGH *v.* EAGLE WHITE LEAD COMPANY, 185 Fed. 769; nor from that of the Circuit Court of Appeals of the Second Circuit in CARROLL & SON CO. *v.* MCILVAINE, 183 Fed. 22. In the first of these cases it was said that the continued, persistent, and adverse use of the trade-mark by the defendant, to plaintiff's knowledge, during 14 years showed an abandonment of an exclusive claim by the plaintiff, and on such abandonment new rights had, in the meanwhile, arisen on the part of the public. It was held that under such circumstances it would be inequitable to arrest, at that late date, the defendant's trade, which had, with the plaintiff's knowledge, been built up upon its trade-mark. In the latter case, although the plaintiff had established the prior use of the designation 'Baltimore Club' as applied to whiskies, it was held that a delay of nearly 20 years, after knowledge of the use of the same designation by the defendant and its predecessors, to prevent such later use, was laches, which would disentitle the plaintiff to an injunction against defendant's use, at least in the territory where the defendant had always used the trade name and where

the plaintiff had not competed with it. True, in each of these cases there were other circumstances mentioned in the opinions; but they in no way affected the decisions on the point in question. To the same effect is VALVOLINE OIL CO. *v.* HAVOLINE OIL CO. (D. C. S. D. N. Y.) 211 Fed. 189, 194."

* * * * *

"In SAXLEHNER *v.* EISNER & MENDELSON CO., 179 U. S. 19, 37, it was held that the failure of one for 20 years to seek to prevent others in this country, although such efforts had been made abroad, from using a trade-name, was such laches as prevented relief, although there was no proof of actual knowledge of infringement in this country, Mr. Justice Brown remarking: 'By 20 years of inaction he has permitted the use of the word by numerous other importers, and it is now too late to resuscitate her original title.'

"FRENCH REPUBLIC *v.* SARATOGA VICHY CO., 191 U. S. 427, 436, is to the same effect.

"It would, in my judgment, be most inequitable to interfere with the defendant's trade under the circumstances of this case. The plaintiff has known of the defendant's use of its trade-name, and has taken no steps whatsoever to prevent it for at least 15 years, during all of which time defendant has been building up its business, which is far greater and more extensive than that of the plaintiff. For one to permit another to build up a reputation for one's goods under a trade-name for a long period of time, and then to assert an exclusive right to that name, and

thereby acquire the benefit of the reputation and trade which the other has built up, when it lay in the power of the former at any time to have arrested the use of the trade-name by the latter, seems to me most inequitable, because, if the right had been asserted before the reputation was acquired the infringer could have adopted another name and built his reputation on it. It would also tend to further deception upon the public, one of the results which injunctive relief in trade-mark cases seeks to prevent. Of course, if one knowingly and willfully adopts a name which has been used by another, a different situation might be presented. Such a case would exhibit actual fraud, and such, I think, is the distinguishing feature between cases such as this and MENENDEZ *v.* HOLT, *supra*. See SAXLEHNER *v.* EISNER & MENDELSON, *supra*, 179 U. S. 39, But nothing of that kind appears in this case.

"It remains, therefore, to consider whether such a defense is applicable to this kind of a suit. The statute provides that the registration of of trade-mark 'shall be *prima facie* evidence of ownership.' Section 16. Section 6 permits any one who believes he would be damaged by the registration of a trade-mark to oppose the same. This latter section has been construed to mean, and I think properly so, that the objector must show such interest in the proposed trade-mark that damage may be inferred. BATTLE CREEK *v.* FULLER, 30 App.

D. C. 411; UNDERWOOD *v.* DICK, 36 App. D. C. 175.

"It is urged by the plaintiff that as it has shown a prior adoption and use of the mark, and as the registration thereof would be only *prima facie* evidence of ownership, the defendant could not be damaged by the registration, because it would have the same right to assert the defense, which it now urges, in any suit which might be brought for an infringement of the trade-mark so registered, as if it were not registered. There are, I think, several answers to this contention. In the first place, I think that the principle under which relief is denied in the cases before mentioned is that the one asserting the exclusive right, although he had such a right at one time, no longer has it, either on the theory that the right has been lost *or that he is estopped from asserting it*, or from denying that it has been abandoned. The latter was considered by the Circuit Court of Appeals of the Eighth Circuit in LAYTON PURE FOOD CO. *v.* CHURCH & DWIGHT, 182 Fed. 35, 41, and apparently by the Circuit Court of Appeals of this Circuit in the Eagle White Lead Suit, *supra*, to be the principle underlying such cases.

"Under any of these theories the defendant would be damaged by the registration of the trade-mark, because it would confer upon the plaintiff a right to which it is not entitled, and which it could assert against the defendant, namely, a *prima facie* title. *Further, it would seem to be ridiculous for*

> *a court to direct the registration of a trade-mark over the opposition of another, when, under the facts presented, it would not permit the owner of the trade-mark the exclusive right to use the same as against the other. In addition, I can readily see that damage would result to the defendant if the plaintiff were permitted to register this trade-mark, because in any suit hereafter brought against the defendant for infringement thereof the burden of disproving the plaintiff's title to the trade-mark as against the defendant would be cast upon the latter.* (Italics supplied.)

Such arguments, *mutatis mutandis*, are equally applicable to the concourse of circumstances which define the case at bar.

It would be most inequitable to permit R. S. Howard either personally or in the name of his creature corporation, to maintain action either in the Patent Office or elsewhere to dislodge from the records a registered trade-mark in the registration of which he had acquiesced with full knowledge for more than fourteen (14) years.

It would be ridiculous for a court to direct or permit such a registered trade-mark, associated for more than fourteen (14) years with an increasing good will and a lucrative business to be cancelled at the instance of one who has been decreed to be without right and enjoined finally and perpetually from making use of the mark in the form registered and finally it is easily to be perceived

that by such cancellation if permitted to occur, damage would necessarily result to The Baldwin Company by reason of the loss of the favored position conferred by statute upon the holder of a registered mark, both with respect to the burden of proof and the right to triple damages in cases for infringement.

Again, R. S. Howard Company suggests that this suit under Section 4915 R. S. U. S. "was not brought in time," that is, "within one year after any action" had in the Patent Office, of which the *applicant* had been given notice.

It is to be noted that in the case at bar R. S. Howard Company is the *applicant,* not The Baldwin Company, as learned counsel for the former would seem to imply.

It was the Howard Company—not the Baldwin Company—that filed application, not for the registration of a trade-mark, but for the cancellation thereof and which required prosecution in the Patent Office under Section 13 of the Trade Mark Act; it was the Howard Company, not The Baldwin Company, that appealed to the Court of Appeals of the District of Columbia under Section 9 of the Trade Mark Act from the refusal by the Commissioner of Patents to cancel The Baldwin Company's registered mark and his dismissal of the Howard Company's application to cancel such registration.

It is true that the Court of Appeals of the Dis-

trict of Columbia, by its opinion filed March 3, 1919, reversed the order of the Commissioner of Patents dismissing the Howard Company's application for cancellation and, further, that the original bill of complaint in the case at bar was only filed May 7, 1921, but it is also true that said bill of complaint was filed in the Supreme Court of the District of Columbia within 30 days after disposition had been made by this Court of the previous proceedings in the cause. It is suggested, however, by our learned opponents that the bar of one year prescribed by Section 4894, R. S. U. S., as amended, takes no account of and makes no allowances for mistake on part of litigants or their counsel, who are so unfortunate as to seek relief in a wrong tribunal. If no other justification for the course pursued by The Baldwin Company were available in the instant suit, it would seem to be reasonably satisfactory and sufficient to call attention to the fact that at the date of the allowance of the appeal to this court the former proceedings, viz., June 9, 1919, and the submission of application by The Baldwin Company for allowance of *certiorari* therein, this honorable court had then pending on its docket the case of Estate of P. D. Beckwith, Inc., *v.* Commissioner of Patents, 250 U. S. 538, involving questions under the Trade Mark Act similar to those in the instant cause in which *certiorari* had been granted November 4, 1918, 248 U. S. 556, and which was considered fully and disposed of on the merits April 19, 1920. It

was not until April 11, 1921, that this court, when disposing of the former phases of the present controversy repudiated jurisdiction in such cases (256 U. S. 40).

Under such circumstances surely equity would not be astute to wring penalties from obscure sources and lead them through tortuous channels, to the detriment of its willing though possibly misinformed devotees.

But we venture to think, and with confidence to submit, that as in GANDY *v.* MARBLE, 132 U. S. 432, and in WESTINGHOUSE ELECTRIC CO. *v.* OHIO BRASS CO., 186 Fed. 518, the ascertained penalty for abandonment, whether actual or putative, was limited solely to the *applicant for the issuance of patent* and by analogy should be limited also to *applicants* for the registration of trade-mark, nevertheless the doctrine invoked by learned opponents has no application here, for so long as the trade-marks in question remain intact of record in the Patent Office and continue to be used by The Baldwin Company in its daily and increasing business, no basis was or can be furnished upon which an envious rival seeking to share improperly in registrant's business can predicate a charge of abandonment, for as The Baldwin Company had no application pending which required prosecution it could not by failing to prosecute that which did not exist be rightly charged with abandonment of the nonexistent.

The Circuit Court of Appeals for the Sixth Cir-

cuit, Denison, Circuit Judge, speaking for the court, in CLEMENTS *v.* KIRBY, 274 Fed. 575, wherein a bill in equity under Revised Statutes, Section 4915, "to procure for Clements the patent issued to Kirby" was under consideration, would seem satisfactorily to have disposed of a like question, as follows (p. 582):

> "Was, then, the filing of this bill barred by the delay of more than one year between May 28, 1915, and June 16, 1916? There is no limitation statute which provides that a bill, under Section 4915, *based upon a refusal by the Commissioner or the Court of Appeals,* must be filed within one year after such refusal—as counsel in argument seem more or less to assume. The only limitation of this character results from the decisions that to file a bill under Section 4915 is, within the contemplation of Section 4894, to 'prosecute' the application for patent, as must be done 'within one year after any action therein,' in order to avoid the inference that the application shall be regarded as abandoned'—unless, even then, the delay may be found to have been unavoidable.
>
> "The question, therefore, is whether this application was abandoned by a failure to prosecute for more than a year. The mere recital of the facts furnishes an indisputable answer. So far from being abandoned, the application was prosecuted with the utmost diligence and persistence. It is true that Clements made no further effort to get these two claims which had been in interference;

but the application is and continues to be a unit, and it is plainly not abandoned unless it is wholly so. Even if it were true that Clements' theory of the further action which should be taken was wholly erroneous, and he was asking action which he should have known he could not get, or even if the Patent Office had lost jurisdiction to do anything except issue the patent, the inference of abandonment would not follow. It is a familiar principle that, though a tribunal may have no power to grant the relief asked, it has jurisdiction to hear and determine the question of power; and we perceive no tenable theory upon which it may be said that Clements' two applications to the Commissioner in June and July, 1916, each followed by 'action' by the Commissioner, are consistent with a then maturing abandonment by him of his application. Even the language of Patent Office Rule 171, 'such proper action as the condition of the case may require,' cannot mean that a request is not 'prosecution' unless it is grantable.

"That inference of abandonment is as much without support in authority as in principle. In GANDY *v.* MARBLE, 122 U. S. 432, 7 Sup. Ct. 1290, 30 L. Ed. 1223, one year and four months more than the specified time had elapsed after the decision of the appeal from the Commissioner, and *no step of any kind had been taken.* It was not denied that the application had been abandoned under Section 4894, if that section applied at all to a suit under Section 4915. In WESTINGHOUSE CO. *v.* OHIO CO. (C. C.)

186 Fed. 518, the facts in this respect are not stated, but it is assumed that the requisite time had elapsed *without the taking of any step in prosecution*—except the filing of a previous bill under Section 4915, which was wholly ineffective because not filed against the right party; and manifestly whether certain action may properly be characterized as prosecution of the claim presents materially and perhaps vitally different questions when it is taken in a tribunal with general jurisdiction and when application is made in a forum which is open in one particular situation only.

* * * * *

"The present situation is not like a writ of error, which is followed in the wrong court until the statutory time for application to the right court is gone. There the limitation runs from the day of the act to be reviewed; here it runs from the time when the plaintiff becomes acquiescent and begins to do nothing. From these considerations, it necessarily follows that, as to the two claims which were in interference, Clements' application for patent had been refused within the meaning of Section 4915, and that it had not been abandoned within the meaning of Section 4894." (Italics supplied.)

As no action of any sort had or has been taken in the Patent Office since the filing by R. S. Howard Company of its applications for cancellation herein, applications did not at any time call for affirmative action by way of "prosecution" or other-

wise, on part of The Baldwin Company, and as the latter's registered marks still remain of record as they have at all times in question heretofore, and as the proceedings initiated by The Baldwin Company at all times since initiation have been judicial in character and have sought but that protection from wrong which the Constitution and the Statutes of the United States guarantee in such and similar cases, such proceedings have been as prompt and as unceasing as the judicial progress through established courts as their processes would permit, it seems to be quite evident that any allegation of "abandonment" or "acquiescense" on part of The Baldwin Company is without foundation in fact or in law.

In addition to the foregoing suggestions, it may pertinently be remarked that no question of merits was presented to or considered by either of the lower courts, save only as the motion to dismiss filed by R. S. Howard Company must be taken as admitting as true all facts properly averred in plaintiff's bill of complaint, and the action of the trial court in granting plaintiff's prayer for an injunction *pendente lite* is to be taken as but evidencing the court's view that the matters and things set forth in defendants' answer and exhibits thereto even though accepted as truth show no sufficient basis for immediate proceedings in the Patent Office under the certificate of conclusions reached by the Court of Appeals, the correctness of which conclusions both in regard to facts assumed and principles of law deemed by said court to be

applicable is seriously and in the only manner permitted to it so to do, being tested out in the case at bar.

Such proceedings as this (under R. S. U. S. 4915) constitute a suit according to the ordinary course of equity practice and procedure. It is not an appeal technical or otherwise from the action of the Commissioner of Patents, nor is the plaintiff to be confined to the record as made in the Patent Office, but his complaint is to be heard upon all competent evidence which he may adduce.

BUTTERWORTH *vs.* HOE, COMMISSIONER, 112 U. S. 50; GANDY *vs.* MARBLE, 122 U. S. 432.

The testimony taken before the Patent Office though touching the same subject matter and between the same "*parties is both incompetent and inadmissible unless a foundation is laid for its introduction as secondary evidence.*"

DOVER *v.* GREENWOOD, 154 Fed. 854;
MANSEN *v.* SLICK, 216 Fed. 164.

The so-called pleas of *res judicata* are not open here at this time, nor is it permissible to discuss the soundness of the conclusions reached by the learned Court of Appeals in its original opinion herein to effect "Howard" being "not only a common surname, but the name of appellant (R. S. Howard Company) Corporation" *sic* was incapable of lawful registry and at the instance of R. S. Howard Company afforded basis for cancellation (R. 63). But The Baldwin Company claims that

the registration in question was had with full consent of the particular Howard who now seeks cancellation and further that "Howard" though "the name of an individual" is so written and impressed as to justify registration under the permissive clause of the Trade Mark Act of 1905 and as amended.

In this connection see Brown on Trade Marks, Vol. 1, 2d Ed., p. 325, Section 326, and elsewhere.

In OLD LEXINGTON CLUB DISTILLERY CO. *v.* KENTUCKY DISTILLERIES & WAREHOUSE COMPANY, 234 Federal 464, and above referred to, objection was made to the registration of a mark to which priority in use was conceded, but for the protection of which and against the use of which over a period of years by a rival, the owner had taken no steps nor made protest. Registration was denied and such administrative action was supported in its entirety by the courts.

In the case at bar application for cancellation of registered marks is made by an envious trade rival after at least fourteen years of acquiescent knowledge of the existence of such registration and after two courts of competent jurisdiction and high repute have declared that as trade designations the marks were the property of and were to be used by The Baldwin Company alone, and had enjoined and debarred R. S. Howard Company from making any trade use thereof in the form registered.

As in the Old Lexington Club Distillery Company case last above cited, the District Court of the

United States for the District of New Jersey declined to adjudicate the rights of the contending parties on demurrer, so in the case at bar and no doubt for similar reasons, the Supreme Court of the District of Columbia denied R. S. Howard Company's motion to dismiss plaintiff's bill of complaint.

As in the last cited case the United States District Court for the District of New Jersey refused to permit registration pending the final determination on its merits of the controversy between the parties, so in the case at bar, the Supreme Court of the District of Columbia enjoined the defendant Robertson, as Commissioner of Patents, *pendente lite*, from cancelling the registrations of the trade-marks in question or from otherwise interfering with the *status quo*.

As upon the record pending before this Court, there is and can be no dispute whatever with regard to matters of fact and the sole question of law attempted to be adjudged in each of the lower courts was but the single question as to the existence of jurisdictional power to entertain such a suit at all, it is submitted with deference that the only question before this Court for determination is still the question of jurisdiction about which the two lower courts differ. Upon the strength of the statutes referred to as construed in the cited cases decided by this Court, such question should be resolved in favor of the existence of controlling judicial power and against the existence of the

suggested executive right to destroy private property and interests therein free from judicial control. Noting the obvious similarity between letters patent of the United States duly issued and commercial trade-marks in active use duly registered, it is suggested that as the former cannot be made void or cancelled subsequent to issue by action of the Patent Office alone, so also, in the case of registered trade-marks, the ultimate right of cancellation when contested should rest with the courts, which upon well-known principles, will yield to executive action, especially when concurrent in two or more branches, the fullest consideration. In connection with this final suggestion, it should steadily be borne in mind that in the case at bar, both the Examiner of Interferences and the Commissioner of Patents who are charged in the written statutes with the primary duty of determining all applications for cancellation of registrations, have concurred in the view and determination that the trade-marks here under consideration are valid and are not reasonably subject to cancellation.

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WM. R. STANS
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SUPREME COURT OF THE UNITED STATES

October Term, 1923.

No. 251.

THE UNITED STATES OF AMERICA,

ex relatione, THE BALDWIN COMPANY,

Appellant-Petitioner,

vs.

THOMAS E. ROBERTSON, as Commissioner of Patents, and R. S. HOWARD COMPANY, Intervenor.

BRIEF OF R. S. HOWARD COMPANY.

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SUPREME COURT OF THE UNITED STATES

October Term, 1923.

No. 251

THE UNITED STATES OF AMERICA, *ex relatione*, THE BALDWIN COMPANY,

Appellant-Petitioner,

vs.

THOMAS E. ROBERTSON, as Commissioner of Patents, and R. S. HOWARD COMPANY,

Intervenor.

BRIEF ON BEHALF OF R. S. HOWARD COMPANY.

Statement of the Case.

This action was brought to enjoin the Commissioner of Patents from cancelling two Trade-Mark Registrations which the Court of Appeals of the District of Columbia has ordered cancelled (48 App. D. C. 437; Rec. pp. 61-65).

Said Registrations are No. 31,411 registered March 8, 1898, by the Valley Gem Piano Company, and No. 46,993 registered October 17, 1905, by The Baldwin Company, appellant.

Both said Registrations are for pianos and both are claimed to be owned by The Baldwin Company, and *use* of both marks is claimed since December 15, 1896.

The "10-year" clause of Sec. 5 of the Trade-Mark Act o 1905 is not involved, because *use* of the marks is *not* claime for the requisite "10-year" period.

Registration No. 31,411 is reproduced on pages 53-r, 53- of the Record; the essential features of this mark "consist of the word 'Howard' in connection with the initials 'VGPCo.' in the form of a monogram".

Registration No. 46,993 is reproduced on pages 53-p, 53-q of the Record and consists solely of the common personal name "Howard".

Appeals to this Court from the Decree of the Court of Appeals of the District of Columbia, decreeing the cancellation of said Registrations, were dismissed, and petitions for writs of certiorari were denied. (256 U. S. 35; 41 Sup. Ct. Rep. 405).

Before the Commissioner of Patents had cancelled said Registrations, pursuant to said decision and decree of the Court of Appeals of the District of Columbia, The Baldwin Company filed its bill of complaint, at bar, in the Supreme Court of the District of Columbia, under Sec. 4915 Rev. Stat., praying that the Commissioner be enjoined from cancelling said Registrations, *pendente lite* and perpetually, and obtained a temporary restraining order.

The R. S. Howard Company (which intervened) filed its answer and moved to dismiss the bill of complaint.

The Supreme Court of the District of Columbia *denied* the motion to dismiss the complaint and *granted* the injunction *pendente lite.*

The Commissioner of Patents and the R. S. Howard Company appealed to the Court of Appeals of the District of Columbia from the decree denying the motion to dismiss the Complaint and granting the injunction *pendente lite.*

The Court of Appeals of the District of Columbia reversed the decision of the Supreme Court of the District of Columbia and ordered that the bill of complaint be dismissed (Rec. pp. 79-84; 287 Fed. 942; 52 App. D. C. 368) saying:

"Believing that there is no authority for the maintenance of this suit we reverse the decision appealed from and remand the case with instructions to dismiss the suit, with costs to be assessed against appellee". (Rec. p. 83).

Thereupon The Baldwin Company appealed to this Court and petitioned for a writ of certiorari. The appeal is now at bar and consideration of the petition for certiorari has been postponed until the hearing upon this appeal.

Appellant now seeks to re-try, *de novo,* said Cancellation Proceedings and claims that Section 4915 R.S. authorizes this action and such re-trial.

Appellant does not attempt to impeach the decree in said Cancellation Proceedings "for fraud, accident or mistake", or for any irregularity in the Cancellation Proceedings, or on the ground that the Court of Appeals of the District of Columbia was without the jurisdiction of the parties or the subject-matter, or on the ground of newly discovered evidence, nor is this action sought to be maintained upon the general principles of equity, but *solely* under Sec. 4915 R.S. (Complaint par. 12, Rec. p. 9).

Respondent contends that Sec. 4915 R. S. does not authorize this action; that the Trial Court is without authority or power to hear or determine this cause; that the trial Court is without power or authority of law to adjudicate concerning the subject-matter of this action or to grant any relief in the premises.

In addition, respondent contends that the claim set forth in the complaint is so unsubstantial as to be without color of merit, and that the action should be dismissed on that ground.

Furthermore, respondent contends that the issue here involved is *res adjudicata,* by reason of the adjudication and determination of the identical issue between the same parties in a former Equity Action in the Federal Courts of the Sec-

ond Circuit wherein every material fact and circumstance alleged at bar was alleged, litigated and *determined* and the identical relief, in substance and effect, now prayed, was *denied.* (See *infra,* pp. 61-64).

The Record before this Court on this Appeal.

Appellant has pleaded the decree in a former Equity Action between appellant and respondent (Rec. pp. 4, 5, 7, 8) and, in its complaint, has made extensive reference to both said Equity Action and the Patent Office Cancellation Proceedings between appellant and respondent (Rec. pp. 5, 6, 8).

Respondent in support of its motion to dismiss the complaint, submitted its answer in which it pleaded the entire record in said Patent Office Cancellation Proceedings, which record includes the record of both Courts in said Equity Action (Complaint, Rec. p. 5).

The issue here and every material allegation and the entire subject-matter of this action *were involved* and *determined* in said former Equity Action between appellant and this respondent (*The Baldwin Co.* v. *R. S. Howard Co.,* 233 Fed. 439; 238 Fed. 154; 243 U. S. 636), the complete record of which is a part of the records of this Court (Case No. 916, October Term, 1916).

The entire subject-matter of this action was also involved in said Patent Office Cancellation Proceedings between this respondent and appellant (*R. S. Howard Co.* v. *The Baldwin Co.,* 48 App. D. C. 437; 256 U. S. 35), the complete record of which is also a part of the records of this Court (Cases Nos. 113 and 139, October Term, 1920).

The portions of said records which appear to counsel to be material and relevant to the issues at bar are contained in the printed record at bar. The matters submitted are the complaint, uncontradicted and unmodified *sworn admissions* of appellant's officers, *public records* and *Court proceedings,* as to which there can be no dispute.

This Court takes judicial notice of its own records; here the parties and the subject-matter are the same.

de Bearn v. *Safe Deposit Co. of Baltimore,* 233 U. S. 24;
Butler v. *Eaton,* 141 U. S. 240;
Bienville Water Co. v. *Mobile,* 186 U. S. 212, 217;
Craemer v. *Washington State,* 168 U. S. 124, 129;
Dimmick v. *Tompkins,* 194 U. S. 540, 548.

Federal Courts take judicial notice of the Rules of the United States Patent Office and of the Trial Court.

U. S. Shipping Board Fleet Corp. v. *Sullivan,* 261 U. S. 146, 148;
Caha v. *United States,* 152 U. S. 221, 222, and cases cited.
Hanley v. *Donoghue,* 116 U. S. 1, 6.
United States v. *Eliason,* 16 Pet. 291;
Gratiot vs. *United States,* 4 How. 80;
James v. *Germania Iron Co.,* 107 Fed. 597, 609.

The Baldwin Company not the first to use "Howard" as a mark for pianos.

R. S. Howard Company was incorporated in April, 1902, forthwith acquired a going piano factory and began and has since continued the manufacture and sale of pianos which it sold throughout the United States from the Atlantic to the Pacific and in a long list of foreign countries, which pianos were marked "Howard" and "R. S. Howard & Co." (Rec. pp. 23-26).

R. S. Howard Company upon its incorporation succeeded to the business, good-will, trade-names and trade marks of Robert S. Howard, its principal organizer, who became and has since continued to be its president and general manager. Robert S. Howard has been continuously in the piano business since 1877 and was selling pianos to dealers in the prin-

cipal cities of the United States from the Atlantic to the Pacific continuously for more than twenty years prior to 1902. (Rec. pp. 23-25).

From 1889 to 1896 Robert S. Howard was continuously selling pianos, made by the New England Piano Company of Boston, Mass. which pianos, at his suggestion and request, were marked "Howard" and "R. S. Howard & Co."; also, beginning in 1893, "Howard & Co." (Rec. pp. 24, 25).

In said Equity Action between appellant and respondent, Judge Hough found that *prior to 1896,* and prior to appellant's claimed use of "Howard",

> "there were thousands sold under the title 'R. S. Howard & Co.', 'Howard, New York', 'Howard & Co., Boston', and 'R. S. Howard & Co., Boston'," and that "no other salesman except Howard sold pianos with the 'Howard' mark upon them". (Rec. p. 47).

Respondent's Motion to Dismiss the Complaint.

This respondent moved in the Trial Court, to dismiss the bill of complaint and urged three separate and distinct grounds (Rec. p. 66):

(a) That the bill of complaint fails to state a cause of action, and is bad in substance;

(b) That said Court is without power or authority to grant the relief prayed for, or any relief in the premises;

(c) That all issues involved in the said above-entitled action are *res adjudicata,* as a matter of law, as appears from the allegations and admissions contained in the bill of complaint and the matters of record, admitted and of which the Court will take judicial notice.

Rules of the Supreme Court of the District of Columbia.

Under the Equity Rules of the Supreme Court of the District of Columbia "demurrers and pleas are abolished", and respondent has pursued the only permissible procedure to secure consideration of the several grounds urged in support of its motion to dismiss. The Equity Rules of the Supreme Court of the District of Columbia provide:

> Rule 32.—"Demurrers and pleas are abolished. Every defense in point of law arising upon the face of the bill, shall be made by motion to dismiss. Every defense heretofore presentable by plea in bar or abatement shall be made in the answer, and may be separately heard and disposed of before the trial of the principal case in the discretion of the court. If the defendant move to dismiss the bill, or any part thereof, the motion may be set down for hearing by either party upon five days' notice, and, if it be denied, answer shall be filed within five days thereafter or a decree *pro confesso* entered."

I.

Has this Court Jurisdiction?

Appellant appears to be in doubt of the jurisdiction of this Court (See Appellant's brief, p. 6, and petition for certiorari, p. 19).

This action is purely a statutory proceeding, brought under Section 4915 R. S., (Complaint par. 12, Rec. p. 9) which appellant asserts is a Patent Law of the United States. (Appellant's brief p. 6).

This Court has foreclosed the question of the right of appeal to this Court in an action under the Patent Laws

of the United States, and has directly held that there is no appeal.

Chott v. *Ewing*, 237 U. S. 197;
Hutchinson v. *Loewy*, 217 U. S., 457;
Gompers vs. *United States*, 233 U. S., 604;
Chapman vs. *United States*, 164 U. S., 436.

In *Durham* v. *Seymour, Com. of Patents*, 161 U. S. 235, 237, 239, which was an appeal from the Court of Appeals of the District of Columbia in an action for a patent under Sec. 4915 R. S., decided before the adoption of the Judicial Code, this Court held that it was without jurisdiction and that there was no right of appeal, saying:

> "the matter in dispute was whether Durham was entitled to a patent as for a patentable invention. * * * the proceeding is in fact necessarily a part of the application for the patent. Considered in this light it is clear that the validity of a patent was not involved.
>
> "And we may add that it appears to us to be quite inconsistent with the intention of Congress for this Court to take jurisdiction on appeals of applications for patents in view of the provisions in relation to appeals from the Circuit Courts of Appeals under the Act of March 3, 1891, c. 517, 26 Stat. 826. *United States* v. *Amer. Bell Telephone Co.*, 159 U. S. 548".

II.

Section 4915 R. S. does not Authorize this Action.

Sec. 4915 R. S. is a statutory provision to *secure* a purely statutory right; that is, to *secure* a patent. Critical attention is respectfully requested to the language of the statute. It reads:

"Sec. 4915. Whenever a patent on application is refused, either by the Commissioner of Patents or by the Supreme Court of the District of Columbia upon appeal from the Commissioner, the applicant may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the Commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication, and otherwise complying with the requirements of law. In all cases, where there is no opposing party, a copy of the bill shall be served on the Commissioner; and all the expenses of the proceeding shall be paid by the applicant, whether the final decision is in his favor or not."

By Act of Feb. 9, 1893, ch. 74; 27 Stat. L., 434, the Court of Appeals of the District of Columbia was substituted for the Supreme Court of the District of Columbia in Sec. 4915 R. S.

It is difficult to conceive in what words Sec. 4915 R. S. could be more explicitly stated. Its language is unmistakably plain.

In *Sweet* v. *United States*, 228 Fed. (C. C. A.) 421, 423, the Court said:

"The conclusive legal presumption is that the legislative body means what it said, and the duty of the Courts is to give effect to its acts, not to amend or repeal them".

In *United States* v. *Chase*, 135 U. S. 255, 262, the Court said:

"It is safe to adopt what the legislature have actually said than to suppose what they meant to say".

Caminetti v. *United States*, 242 U. S. 470;
Hamilton v. *Rathbone*, 175 U. S. 414, 421;
United States v. *Hartwell*, 6 Wall. 385, 396;
United States v. *Goldenberg*, 168 U. S. 95.

Sec. 4915 R. S. (as pointed out by Judge Aldrich in *Greenwood* v. *Dover*, 194 Fed. (C. C. A.) 90, 97) has come down to us without substantial change from the time when there was no review by any Court or Judge of decisions of the Commissioner of Patents. Its language goes back to the Patent Act of 1836 when there was first created a Board of Examiners.

In *Butterworth* v. *Hoe*, 112 U. S. 50, and in *United States* v. *Duell*, 172 U. S. 576, this Court summarized all the instrumentalities provided by Congress since the foundation of the Government for the granting of patents and traced the development of appeals, viz:

In 1793 appeals might be taken to three arbitrators; in 1836 appeals might be taken to the Board of Examiners composed of three dis-interested persons whose decision was to be certified to the Commissioner of Patents who "shall be governed thereby in further proceedings to be had on such application," and remedy by bill in equity was first provided; in 1839, somewhat modified in 1849 and 1852, appeal was provided from the Commissioner to one of the Judges of the Circuit Court of the District of Columbia; in 1870 an appeal was provided from the decision of the Commissioner to the Supreme Court of the District of Columbia sitting in banc "whose decision was to govern further proceedings in the case"; in 1893 appeals were transferred from the Supreme Court of the District of Columbia sitting in banc to the Court of Appeals of the District of Columbia, which is the present status.

Patents and Trade-Marks are substantially different.

In *United States* vs. *Duell*, 172 U. S., 576, 586, (quoting with approval from *Butterworth* v. *Hoe*, 112 U. S. 50), "in deciding whether a patent shall issue or not", the Court said:

> "The questions of fact in this field find their answer in every department of physical science, in every branch of mechanical art; the questions of law, necessary to be applied in the settlement of this class of public and private right, have founded a special branch of technical jurisdiction. The investigation of every claim presented involves the adjudication of disputed questions of fact, upon scientific or legal principles, and is, therefore, essentially judicial in its character, and requires the intelligent judgment of a trained body of skilled officials, expert in the various branches of science and art, learned in the history of invention, and proceeding by fixed rules of systematic conclusions".

While Congress provided for the granting of patents in 1790 (Ch. 7, 1 Stat. 109) it made no enactment in any way relating to trade-marks until 1870, and no valid enactment prior to 1881. That there is a wide and substantial difference between patents and trade-marks is shown by a comparison of the language quoted above from *Butterworth* v. *Hoe*, and that found in the *Trade-Mark cases*, 100 U. S. 82, 94, where the Court said:

> "Any attempt, however, to identify the essential characteristics of a trade-mark with inventions and discoveries in the arts and sciences, or with writings of authors, will show that the effort is surrounded with insurmountable difficulties.
>
> "The ordinary trade-mark has no necessary relation to invention or discovery. The trade-mark recognized by the common law is generally the growth of a considerable period of use, rather than a sudden invention.

It is often the result of accident rather than design, and when under the Act of Congress it is sought to establish it by registration, neither originality, invention, discovery or science nor art, is in any way essential to the right conferred by the Act."

The registration of a Trade-Mark is solely a statutory privilege and the statutory limitations are strictly construed.

When the exercise of power depends wholly on statute, the limitations and scope of the statute become jurisdictional problems.

In *United States* v. *Am. Bell Telephone Co.*, 167 U. S. 224, 247, referring to the provisions of the Patent Statutes, the Court said:

> "These are questions not of natural but purely statutory right. * * * No Court can disregard any statutory provisions in respect to these matters on the ground that in its judgment they are unwise or prejudicial to the interests of the public".

That the statutory limitations of the Trade-Mark Acts have been *strictly construed* is illustrated by a host of cases, of which the following are a few:

Stark Bros. v. *Stark*, 255 U. S., 50. Held: No damages can be recovered in an action for infringement of registered trade-mark except on proof that defendant was notified of the registration by actual notice or constructive statutory notice by marking the goods as required by the statute, and notice to "discontinue the unfair competition and infringement of our rights" not sufficient as a basis to recover damages under the Trade-Mark Statute.

Elgin Nat'l Watch Co. v. *Illinois Watchcase Co.,* 179 U. S., 665. Held: Where a word or name had been improperly registered, or registered without authority of Law, the registration conferred no rights or benefits under the Trade-Mark Statutes. He can register only what he has used in foreign commerce or lawful commerce with Indian tribes. *Warner* v. *Searle & Hereth Co.,* 191 U. S. 195.

Ryder v. *Holt,* 128 U. S. 525. Held: Where bill did not allege that the mark was used by defendant on goods intended to be transported to a foreign country, the Federal Court had no jurisdiction, and where proof of that fact was not presented the bill was dismissed. *Warner* v. *Searle & Hereth Co.,* 191 U. S., 195, to the same effect.

Corbin v. *Gould,* 133 U. S., 308: Held: That use and registration of the words "The Tycoon Tea" enclosed in a diamond shaped figure, "the essential features of which are the symbol of a diamond and the arbitrary selected word 'Tycoon'," conferred no exclusive right to the word "Tycoon" *simpliciter.*

A. Leschen Rope Co. v. *Broderick Co.,* 201 U. S., 166; Held: The use of a strand of rope painted red did not support the registration of a mark consisting "of a red or distinctively colored streak applied to or woven in a wire rope."

Ammon & Person v. *Narragansett Dairy Co.,* 252 Fed., 276; 262 Fed. (C. C. A.) 880. Held: That use of "Queen of the West" did not show the prerequisite statutory use to authorize the registration of "Queen", *simpliciter.*

Armour & Co. v. *Louisville Prov. Co.*, 283 Fed. (C. C. A.) 42, Held: That the use of "Armour's Star" was not adoption or use of "Star," and the registration of "Armour's Star" did not support a claim for infringement of "Star."

Diederich v. *Schneider Co.*, 195 Fed. (C. C. A.) 31. Held: That one acquires no right to register a trade-mark unless the mark is used on a vendable commodity and plaintiff can have no relief under the Registration Statutes unless the mark is placed by the defendant on a vendable commodity sold or intended to be sold in commerce among the States, foreign nations, or Indian tribes; *Warner* v. *Searle & Hereth Co.*, 191 U. S., 195.

Bronson v. *Duell*, 17 App. D. C., 471. Held: "The lawful right to convert a mark or symbol into a trade-mark was intended to remain a prerequisite to registration", and that the mark must be such a mark as could be lawfully exclusively appropriated.

The Trade-Mark Registration Provisions are not only statutory but arbitrary.

The possession of a technical trade-mark, good at common law, does not necessarily confer the privilege to register.

By the Trade-Mark Act, Congress Granted Power to Cancel Trade-Mark Registrations Exclusively to the Commissioner of Patents, Subject only to Review by the Court of Appeals of the District of Columbia.

Prior to the Trade-Mark Act of 1905, there was no provision for cancelling a trade-mark registration, and there was no direct review, judicial or administrative, by appeal or

otherwise, of decisions of the Commissioner of Patents upon matters relating to the registration of trade-marks. (*South Carolina* v. *Seymour,* 153 U. S. 353, 355).

No Court has ever assumed the right to cancel a trade-mark registration, except the Court of Appeals of the District of Columbia by the procedure expressly provided by the Trade-Mark Act itself.

The Trade-Mark Act of 1905 (33 Stat. 724 et seq.) provides for the cancellation of trade-mark registrations as follows:

> "Sec. 13. That whenever any person shall deem himself injured by the registration of a trade-mark in the Patent Office he may at any time apply to the Commissioner of Patents to cancel the registration thereof. The commissioner shall refer such application to the examiner in charge of interferences, who is empowered to hear and determine this question and who shall give notice thereof to the registrant. If it appear after a hearing before the examiner that the registrant was not entitled to the use of the mark at the date of his application for registration thereof, or that the mark is not used by the registrant, or has been abandoned, and the examiner shall so decide, the commissioner shall cancel the registration. Appeal may be taken to the commissioner in person from the decision of examiner of interferences."

By Sec. 9 of the Act, (33 Stat. 727) appeal may be taken from the Commissioner to the Court of Appeals of the District of Columbia.

The "use" referred to in the first condition has been repeatedly held "to mean the right of exclusive use." *Magic Curler Co.* v. *Porter,* C. D. 1907, 163.

In *Planten* v. *Gedney,* 224 Fed. (C. C. A.) 382, 384, 385, Judge Lacombe, writing for the Court of Appeals of the 2nd Circuit, respecting registrations improperly or improvidently granted, said of this cancellation Section:

"The remedy is full, fair and summary, with appeal from the Examiner to the Commissioner, and with no time limit for the application."

Section 22 (33 Stat. 729) of the Trade-Mark Act of 1905 provides for the cancellation of trade-mark registrations when there are *interfering registrations*, and reads as follows:

"Sec. 22.—That whenever there are interfering registered trade-marks, any person interested in any one of them may have relief against the interfering registrant, and all persons interested under him, by suit in equity against the registrant; and the Court, on notice to adverse parties and other due proceedings had according to the course of equity, may adjudge and declare either of the registrations void in whole or in part according to the interest of the parties in the trade-mark, and may order the certificate of registration to be delivered up to the Commissioner of Patents for cancellation."

This Sec. 22, applicable to trade-marks, corresponds to Section 4918 R. S., which provides, when there are *interfering patents*, that any person interested in any one of them may bring suit in equity for relief and the Court may adjudge and declare either of the patents void in whole or in part, or inoperative, or invalid, according to the interest of the parties in the invention patented.

The Trade-Mark Act fully provides for every case, both when the Commissioner wrongfully refuses to register a trade-mark, and when he erroneously grants registration.

No trade-mark registration has ever been cancelled under Sec. 4915 *R. S.; no patent has ever been cancelled under Sec.* 4915 *R. S.*

Except in the case of interfering patents, it is settled law that patents for inventions may be cancelled *only* by the

United States, and *only* under the general principles of equity, and this right is *solely* within the power of the United States. It has been settled that Sec. 4915 R. S. does *not* authorize an action to *cancel* a patent, even by the United States.

Mowry v. *Whitney, 14 Wall,* 434, 439;
United States v. *Bell Tel. Co.,* 128 U. S. 315, 368-370;
United States v. *Amer. Bell Tel. Co.,* 159 U. S. 548, 555;
Briggs v. *United Shoe Mach. Co.,* 239 U. S. 48.

In *United States* v. *Bell Tel. Co.,* 128 U. S. 315, 369, referring to *Mowry* v. *Whitney, supra,* and the right of a private citizen to prosecute an action to cancel a patent, the Court said:

> "It is true that what the Court was called upon to decide (in *Mowry* v. *Whitney*) was that a private citizen could not bring such suit, but evidently the reason given for it must be held to establish the principle upon which the Court acted, and that reason was that the private citizen could not do it because the right lay with the Government".

In *United States* v. *Am. Bell Tel. Co.,* 159 U. S., 458, this Court held that an action by the United States to *cancel* a patent was *not* a suit "arising under the patent law"; but that such an action must be prosecuted under the general principles of equity. *United States* v. *Bell Tel. Co.,* 128 U. S. 315, 359, 368-370.

To "interpret" Sec. 4915 R. S. as authorizing the action at bar, which is *to enjoin the cancellation of a trade-mark registration,* requires a rewriting of Section 4915 R. S., and the incorporation into the Section of both words and subject-matter entirely foreign to its present plain language; such an interpretation

"is not to be attained by striking out or disregarding words that are in the section, but by inserting those that are not there now. This is no part of our duty". (*Trade-Mark Cases,* 100 U. S. 82, 99; *Hill* v. *Wallace,* 259 U. S., 44, 71).

In *United States* v. *Temple,* 105 U. S., 97, 99, this Court said:

"When the language is plain, we have no right to insert words and phrases, so as to incorporate in the statute a new and distinct provision".

Bate Refrigerator Co. v. *Sulzberger,* 157 U. S. 136. *Conona Coal Co.* v. *United States,* O. T. 1923, No. 42.

In *United States* v. *First Nat. Bank,* 234 U. S. 245, 262, the Court said:

"The responsibility for the justice or wisdom of legislation rests with Congress, and it is the province of the Courts to enforce, not to make, the laws. *St. Louis Iron Mt. & S. Ry. Co.* v. *Taylor,* 210 U. S. 281, 294, 295; *Texas Cement Co.* v. *McCord,* 233 U. S., 157, 163".

As far as counsel has been able to discover, there has been only one decision which even touches the question at bar, *by any Court,* during the years since trade-marks have been registered, and that was in the recent case of *Loughran* v. *Quaker City Chocolate Co.,* 286 Fed. 694, (Feb. 15, 1923) in which the Court held that Sec. 4915 R. S. did *not* authorize an action to *cancel* a trade-mark registration, although it held that Sec. 4915 authorized an application to secure registration of a trade-mark. The Court said (p. 698):

"The other prayer for the cancellation of defendant's trade-mark, although reserved as a trial question, (same case 281 Fed. 23), was reserved with the plain intimation that this Court was without jurisdiction to interfere with the Patent Office disposition made of applications which had been granted.

"To this opinion we adhere, and this prayer should be denied. We do not regard *Baldwin* v. *Howard,* 256 U. S. 35; 41 Sup. Ct. 405; 65 L. ed. 816. as in conflict with this ruling, but on the contrary as in line with it."

It is respectfully submitted that *Atkins* v. *Moore,* 212 U. S. 285, and *Am. Steel Founderies* v. *Robertson,* 262 U. S. 209, have no application to the case at bar, because those cases have to do *solely* with *securing* the *registration* of a Trade-Mark, while the case at bar has to do with the *cancellation* of a registration; that is, to *enjoin* a cancellation.

If Sec. 4915 R. S. does not authorize an action to *cancel* a *patent,* much less can it be interpreted to authorize an action to *cancel* the *registration* of a mark; and much less still to authorize an action to *enjoin* the cancellation of a registration of a mark which the Court of Appeals of the District of Columbia has adjudged should be cancelled.

In *Westinghouse Elec. Mfg. Co.* v. *Ohio Brass Co.* 186 Fed. 518, 520, which was an action for a patent under Sec. 4915 R. S., the Court said:

"The right to retry the merits of an application for a patent, by bill in equity, * * * is purely statutory, and is subject to such restrictions as Congress may prescribe."

III.

The Supreme Court of the District of Columbia is without Authority of Law to Adjudicate upon the Subject-Matter of this Action.

The jurisdiction of the Supreme Court of the District of Columbia is challenged on the ground that it is *without cognizance of this case* or *of the class of cases* to which this case belongs; that it is without authority or power to hear and determine this cause or to adjudicate concerning the subject-

matter here involved (*Cooper* v. *Reynolds,* 10 Wall. 308, 316; *In re Sawyer,* 124 U. S. 200).

There is no *presumption* of jurisdiction where a Court, although it is one of general jurisdiction, is called upon to exercise *special statutory powers* (*Galpin* v. *Page,* 18 Wall. 350, 370-372), nor is there ever any *presumption* that Congress intended to provide a further review or a re-trial. (*Ferry* v. *United States,* 85 Fed. (C.C.A.) 550, 555).

> "Jurisdiction may be defined to be the right to adjudicate concerning the subject-matter in the given case. To constitute this there are three essentials: First, the Court must have cognizance of the class of cases to which the one to be adjudged belongs; second, the proper parties must be present; third, the point decided must be, in substance and effect, within the issue." *Reynolds* v. *Stockton,* 140 U. S., 254, 268.

Respondent contends that all provisions provided by Congress for the cancellation of trade-mark registrations are contained in Sections 13 and 9 of the Trade-Mark Act of 1905, and that *these provisions are exclusive,* whether regarded as judicial or administrative (except as provided by Section 22 of said Act which is applicable only when there are interfering registrations).

It is familiar doctrine that where a right, privilege or remedy is created by statute, the provisions therein provided by the statute govern, limit and control the right or remedy, and that the provisions thus provided by the statute are *exclusive. Wilder Mfg. Co.* v. *Corn Products Co.,* 236 U. S. 165, 174, 175, and cases cited.

By the Trade-Mark Act itself Congress regulated the whole subject of cancellation of trade-mark registrations, which was a subject-matter entirely within its control and discretion (*United States* v. *Bell Tel. Co.,* 167 U. S. 224; *United States* v. *Duell,* 172 U. S. 576, 589); the provisions which Congress

made are comprehensive; they embrace the whole subject; it is respectfully submitted that these provisions are exclusive.

It is plain that the cancellation provision "was a new remedy", provided as a part of the registration statute itself, "and as the mode of pursuing it was specially pointed out, that mode must be pursued", and that "the remedy thus prescribed is exclusive of all others".

Arnson v. *Murphy,* 109 U. S. 238;
Middletown Nat. Bank v. *Toledo A. A. & N. M. Ry,* 197 U. S. 394;
Cook County Bank v. *United States,* 107 U. S. 445, 451;
Jackson v. *Cravens,* 238 Fed. (C. C. A.) 117, 120.

In *Butterworth* v. *Hoe,* 112 U. S. 50, 63, which was a proceeding to mandamus the Commissioner to issue a patent, wherein this Court *denied* that the Secretary of the Interior had the right to review the decisions of the Commissioner, the Court said:

> "the principle applies that where a special proceeding is expressly ordained for a particular purpose it is presumably exclusive * * *
>
> (p. 64) "The true conclusion, therefore, is, that in matters of this description in which the action of the Commissioner is quasi-judicial, the fact that no appeal is expressly given to the Secretary is conclusive that none is to be implied".

In *Cook Co. Bank* vs. *United States,* 107 U. S. 445, 451, the Court said, referring to the National Banking Act:

> "A law embracing an entire subject, dealing with it in all its phases, may thus withdraw the subject from the operation of a general law as effectively as though, as to such subject, the general law were in terms repealed".

Jackson v. *Cravens,* 238 Fed. (C. C. A.) 117, 120, involved the granting of an injunction to restrain the enforcement of a State statute under Sec. 266 of the Judicial Code:

> "We think the contention of appellants also conflicts with the rule of construction that when a statute provides a new, specific, and complete remedy, and fully covers the subject-matter, the provisions of the statute will be looked to alone, and resort will not be had to prior existing general remedies as cumulative". (*Cumberland Tel. Co.* vs. *Louisiana Pub. Serv. Comm.,* 260 U. S. 212).

> *Brown* v. *United States,* 171 U. S. 631;
> *Laurel Oil Co.* v. *Morrison,* 212 U. S. 291;
> *Central Trust Co.* v. *Sneders,* 239 U. S. 11;
> *United States* v. *Chase,* 135 U. S. 255, 260;
> *Townsend* v. *Little,* 109 U. S. 504, 512.

In *Globe Newspaper Co.* v. *Walker,* 210 U. S. 356, 363, 367, an action for infringement of copyright of a map, a demurrer was sustained on the ground that the *copyright law gave no such action,* and dismissed the bill for want of jurisdiction; this Court affirmed, saying:

> "Congress not only created a new right in the copyright statute, but that the remedies therein given are the only ones open to those seeking the benefits of the statutory right thereby created. * * *
>
> "It thus appears that Congress has prescribed the remedies it intends to give, this being true, 'however inadequate,' as Lord Kenyon said in *Beckford* v. *Hood, supra,* 'no others can be resorted to'."

In *Hills & Co.* v. *Hoover,* 220 U. S. 329, 337, this Court said:

> "The copyright statutes of the United States afford all the relief to which a party is entitled, and no action outside of those provided therein will lie. *Globe Newspaper Co.* v. *Walker,* 210 U. S. 356".

In *Blumenstock Bros.* v. *Curtis Pub. Co.*, 252 U. S. 436, 440, 441, an action under the Sherman Anti-Trust Act which was dismissed for want of jurisdiction because the complaint failed to state a cause of action within the provisions of the Act, this Court, in affirming the dismissal, said:

> "In order to maintain a suit under this Act the complaint must state a substantial case arising thereunder. The action is wholly statutory, and can only be brought in a District Court of the United States, and it is essential to the jurisdiction of the Court in such cases that a substantial cause of action *within the statute* be set up".
>
> "In cases where, as here, the controversy concerns a subject-matter limited by federal law, for which recovery can be had only in the federal courts, the jurisdiction attaches only when the suit presents a substantial claim *under an Act of Congress.* This rule has been applied in bankruptcy cases (*Grant Shoe Co.* v. *Laird Co.*, 212 U. S. 445); in copyright cases (*Globe Newspaper Co.* v. *Walker*, 210 U. S. 356); in patent cases (*Healy* v. *Sea Gull Specialty Co.*, 237 U. S. 479); in Admiralty cases. (The Jefferson, 215 U. S. 130)". (Italics Ours)

Also, as to the Sherman Anti-Trust Act: *Geddes* vs. *Anaconda Mining Company*, 254 U. S. 590; *Paine Lumber Co.* vs. *Neal*, 244 U. S. 459, 471.

Also, "applied to establishment and government of National Banks as in a separate Code by itself, neither limited nor enlarged by other statutory provisions". *Cook County Bank* vs. *United States*, 107 U. S. 445, 451; also, *Farmers Nat. Bank* vs. *Dearing*, 91 U. S. 29, 33; *Barnett* vs. *Nat. Bank*, 98 U. S. 555, 558.

Also, under the Revenue Laws, *Arnson* vs. *Murphy*, 109 U. S. 238.

Also, as to Pension Laws, *United States* vs. *Black*, 128 U. S. 40 and cases cited.

Also, as to many provisions of the Public Land Laws. *Cameron* vs. *United States*, 252 U. S. 450; *Maxwell Land Grant case*, 121 U. S. 325, 380, and cases cited; Indian Land cases, *McKay* v. *Kalyton*, 204 U. S. 258.

Also, as to the immigration statutes, *Japanese Immigration case*, 189 U. S. 86, and cases cited.

Also, as to the postal laws, *United States* v. *Wright*, 11 Wall, 648; *Bates & Guild Co.* vs. *Payne*, 194 U. S. 106.

Also, as to the Interstate Commerce Act, *Croninger case*, 225 U. S. 491; *Louisville & Nashville R. R. Co.* v. *Rice*, 247 U. S. 201.

If the Trade-Mark Registration statutes are to be regarded as administrative provisions, the Courts have no jurisdiction to review their quasi-judicial decisions beyond what is *expressly* conferred by the Trade-Mark Acts themselves. *Keller* v. *Potomac Elec. Co.*, 261 U. S. 428, 443.

In *United States* vs. *Duell*, 172 U. S. 576, 588, 589, the plaintiff applied to mandamus the Commissioner to issue a patent to him after the Court of Appeals of the District of Columbia had decided against him in a patent interference case. Referring to *Butterworth* v. *Hoe*, 112 U. S. 50, the Court said:

> "We perceive no ground for overruling that case or dissenting from the reasoning of the opinion; and as the proceeding in the Court of Appeals on an appeal in an interference controversy presents all the features of a civil case, a plaintiff, a defendant and a Judge, and deals with a question judicial in its nature, in respect

of which the judgment of the Court is final so far as the particular action of the Patent Office is concerned, such judgment is none the less a judgment 'because its effect may be to aid an administrative or executive body in the performance of duties legally imposed upon it by Congress in execution of a power granted by the Constitution'. *Interstate Commerce Commission* vs. *Brimson*, 154 U. S. 147".

(p. 589) "By the Acts of 1839 and 1852 an appeal was given, not to the Circuit Court of the District of Columbia, but to the Chief Judge or one of the Assistant Judges thereof, who was thus called on to act as a special tribunal. The competency of Congress to make use of such an instrumentality or create such a tribunal in the attainment of the ends of the Patent Office seems never to have been questioned and we think could not have been successfully.

(p. 583) "it will be seen that from 1790 Congress has selected such instrumentalities, varying from time to time, and since 1870, has asserted the power to avail itself of the Courts of the District of Columbia in that connection. It follows that Congress may provide such instrumentalities as in its judgment would be best calculated to effect that object".

United States v. *Coe*, 155 U. S. 76.

Ness v. *Fisher*, 223 U. S. 683, 693, 694, was a petition for a mandamus to compel the Secretary of the Interior to accept an application to purchase public timberland, which application was refused because it failed to disclose that applicant had personally examined the land and had failed to state that it was unfit for cultivation. The rejection was based upon the construction of the Act of Congress governing the sale of such land (concerning which there had been different Court constructions) which required the statement to be verified by the oath of the applicant. The Court said:

"So, at the outset we are confronted with the question, not whether the decision of the Secretary was right or wrong, but whether a decision of that officer, made in the discharge of a duty imposed by law and involving the exercise of judgment and discretion, may be reviewed by mandamus, and he be compelled to retract it, and to give effect to another not his own and not having his approval." (The Court said this question had often been answered in the negative, citing cases; continuing, said):

"The Court could not entertain an appeal from the decision of one of the secretaries, nor revise his judgment in any case where the law authorized him to exercise discretion or judgment, nor can it by mandamus, act directly upon the officer, and guide and control his judgment or discretion in the matter committed to his care, in the ordinary discharge of his official duties. * * * Whether he decided right or wrong is not the question. * * *

"Nor does the fact that no writ of error will lie in such a case as this, by which to review the judgment of the Secretary, furnish any foundation for the claim that mandamus may therefore be awarded. The responsibility as well as the power rests with the Secretary, uncontrolled by the Courts".

Congress in numerous instances has provided for final termination by executive or administrative officers or quasi-judicial tribunals, and in such cases their decision, or the sufficiency of the evidence on which they act, cannot be reviewed by any Court unless expressly provided by statute. *Fong Yue Ting* v. *United States*, 149 U. S. 698, 714, 715 and cases cited.

In *Bates & Guild Co.* vs. *Payne*, 194 U. S. 106, 109, which was an action to enjoin the enforcement of an order denying classification of mail as second-class matter, this Court said:

"In the early case of *Decatur* v. *Paulding,* 14 Pet. 497, it was said that the official duties of the head of an executive department, whether imposed by Act of Congress or by resolution, are not merely ministerial duties; and as was said in the recent case of *Riverside Oil Co.* v. *Hitchcock,* 190 U. S. 316, 324: 'Whether he decided right or wrong is not the question. Having jurisdiction to decide at all, he had necessarily jurisdiction, and it was his duty to decide as he thought the law was, and the Courts have no power whatever under those circumstances to review his determination by mandamus or injunction'.

"In *Marquez* v. *Frisbie,* 101 U. S. 473, which was a bill in equity to review the decision of the Land Department in a preemption case, Mr. Justice Miller remarked (p. 476): 'This means, and it is a sound principle, that where there is a mixed question of law and fact, and the Court cannot so separate it as to show clearly where the mistake of law is, the decision of the tribunal to which the law had confided the matter is conclusive'.

"In *Gaines* v. *Thompson,* 7 Wall. 347, it was held that the Court would no more interfere by injunction than by mandamus to control the action of the head of a department; and in *United States ex rel. Dunlop* v. *Black,* 128 U. S. 40, it was said that the Courts will not interfere by mandamus with the executive officers of the Government in the exercise of their ordinary official duties, even when those duties require interpretation of the law, no appellate power being given them for that purpose. See also *Redfield* v. *Windham,* 137 U. S. 636."

In *United States* vs. *Wright,* 11 Wall. 648, 650, in an action under an act of Congress to allow extra compensation when approved by the Postmaster General, the Court said:

"It may be safely laid down, says Story, Judge, 'that where a particular authority is confided to a public officer

to be exercised by him in his discretion, upon an examination of facts, of which he is made the appropriate Judge, his decision upon the facts is, in the absence of any controlling provisions, absolutely conclusive as to the existence of those facts.'" Held: that the decision of the Postmaster General was not subject to review anywhere.

Questions of fact determined by an administrative or executive department of the Government, unless clearly wrong, is conclusive. *Japanese Immigration case,* 189 U. S. 86, 97, 98, and cases cited.

In *Murrys Lessee* v. *Hoboken Land Co.,* 18 How. 272, 284, (cited and quoted from, with approval, *United States* vs. *Duell,* 172 U. S., 576, 582, 583) the Court said:

"There are matters, involving public rights, which may be presented in such form that the judicial power is capable of acting on them, and which are susceptible of judicial determination, but which Congress may or may not bring within the cognizance of the Courts of the United States, as it may deem proper. * * * Thus it has been repeatedly decided in this class of cases that, upon the trial, the acts of executive officers, done under the authority of Congress, were conclusive, either upon particular facts involved in the inquiry or upon the whole title. *Foley* v. *Harrison,* 15 How. 433; *Burgess* v. *Gray,* 16 How. 48;———v. *The Minnesota Mining Company* at the present term.

"It is true, also, that even in a suit between private persons to try a question of private right, the action of the executive power, upon a matter committed to its determination by the Constitutional laws, is conclusive. *Luther* v. *Borden,* 7 How. 1; *Doe* v. *Braden,* 16 How, 635."

It is respectfully submitted that a cancellation adjudication is a case where Congress has expressly "confided to

a special tribunal the authority to hear and determine certain matters arising in the course of its duties, the decision of that tribunal, within the scope of its authority, is conclusive upon all others", it is clearly unassailable for mere errors of judgment.

The Court of Appeals of the District of Columbia has adjudged, after full review, that the two trade-mark registrations here involved should be cancelled. It is respectfully submitted that this statutory review is exclusive; that all review provided by Congress has been exhausted. Therefore, the decree below should be affirmed for want of jurisdiction of the trial Court.

IV.

Action at Bar was not Brought in Time.

This is a Jurisdictional Question.

If it be held that Section 4915 R. S. authorizes this action, it is respectfully submitted that the case at bar was not brought in time.

This is a jurisdictional question because it is a question of statutory power which goes directly to the jurisdiction of the Court limited, as it is, by the statutory provisions.

It has been settled by the decisions of this Court that an action under Sec. 4915 MUST BE BROUGHT WITHIN ONE YEAR from the date of the decision of the Court of Appeals of the District of Columbia in the Patent Office proceeding, unless excuse "to the satisfaction of the Court" is *pleaded* and *shown*. None is here pleaded.

The action at bar was not brought until more than *two years and two months* after the decision of the Court of Appeals of the District of Columbia in the Patent Office proceedings (Rec. pp. 11, 65).

Gandy v. *Marble,* 132 U. S. 432, was an action for a patent under Sec. 4915 R. S. after refusal by the Commissioner and the Supreme Court of the District of Columbia where the only question considered or decided was whether the action had been begun in time. *The Court dismissed the Complaint* holding that an action under Sec. 4915 R. S. is "in fact and necessarily a part of the application for a patent"; that such action is subject to the requirement of Sec. 4894 R. S.; that the action must be begun within two years (now one year) from the *decision* of the Court refusing the patent and by "otherwise complying with the requirements of law". The Court said (pp. 432, 439, 440):

> "One requirement of law is, by Sec. 4894, that the application shall be regarded as abandoned if the applicant fails to prosecute the same within two years after action therein of which notice shall have been given to him 'unless it be shown to the satisfaction of the Commissioner of Patents that such delay was unavoidable'. * * *
>
> "In the present case, there would be no compliance with the requirement of law, in view of the delay for more than two years, unless it be shown to the satisfaction of the Court that the delay was unavoidable. The jurisdiction of the application being transferred, *pro tanto,* to the Court, by virtue of the bill in equity, it cannot adjudge that the applicant is entitled, according to law, to receive a patent, unless he shows to the satisfaction of the Court that the delay was unavoidable, under an allegation to that effect in the bill." * * *
>
> "No excuse for the laches or delay is set up in the bill nor is it alleged that the delay was unavoidable."

This holding was repeated in *Butterworth* v. *Hoe,* 112 U. S. 50, and quoted with approval in *American Steel Foundries Co.* v. *Robertson,* 262 U. S. 209; any claim to the contrary would be without color of merit.

Coleman v. *American Mach. Co.*, 235 Fed. 531, 532, 537.
McKnight v. *Metal etc. Co.*, 128 Fed. 51.

In *American Steel Foundries* vs. *Robertson*, 262 U. S. 209, 212, 213, this Court cited *Gandy* v. *Marble, supra*, and said:

> "That Court dismissed the bill on the ground that the applicant had failed to prosecute his application within two years (now one year) after the dismissal of his appeal from the Commissioner by the Supreme Court of the District, basing it on Sec. 4894 of the Revised Statutes, reading as follows": (quoting the statute).

Sec. 4894 was amended by Act of March 3rd, 1897, Ch. 391, 29 Stat. 694, whereby the "two-year" period was reduced to one year.

In re Hien, 166 U. S. 432, 438, this Court said:

> "It was held (in *Gandy* v. *Marble, supra*) that the bill in equity (under Sec. 4915 R. S.) was *sub modo* a branch of the application for the patent and was governed by the rule as to laches and delay declared by Sec. 4894".

Sec. 4894 reads in part as follows:

> "upon failure of the applicant to prosecute the same within one year after any action therein, of which notice shall have been given to the applicant, they shall be regarded as abandoned by the parties thereto, unless it can be shown to the satisfaction of the Commissioner of Patents that such delay was unavoidable".

In *Westinghouse Elec. Co.* v. *Ohio Brass Co.*, 186 Fed. 518, where a bill in equity brought under Sec. 4915 for a patent was dismissed, because not brought in time, the Court said:

> "The failure of complainants to institute the present proceedings within one year after the last official action

on their application for Letters Patent, viz: the adverse decision of the Court of Appeals of the District of Columbia, is a bar to such proceedings". * * *

"The right to retry the merits of an application for a patent, by bill in equity, * * * is purely statutory, and is subject to such restrictions as Congress may prescribe.

In *McKnight* v. *Metals Co.,* 128 Fed. 51, there had been no action in the Patent Office after the decision of the Court of Appeals of the District of Columbia prior to bringing action under Sec. 4915 R. S.; this held to be immaterial "since the decision of the Court of Appeals is to govern further proceedings in the case, as provided by Section 4914." No case modifying or to the contrary has been found.

Sutton v. *Wentworth,* 247 Fed. (C. C. A.) 493, 502.

The decision, order and decree of the Court of Appeals of the District of Columbia in said Patent Office proceedings were made and entered March 3, 1919, (Rec. p. 65), and the bill of complaint at bar was filed May 7, 1921 (Rec. p. 11).

The appeals of the Baldwin Company to the Supreme Court of the United States, which were dismissed for want of jurisdiction and its applications for writs of certiorari which were denied (256 U. S. 35), cannot be held to have extended the time within which to file the bill of complaint at bar (*Westinghouse Elec. Co.* v. *Ohio Brass Co.,* 186 Fed. 518; *McMillan Contracting Co.* v. *Abernathy,* O. T. 1923, Nos. 167, 168; 68 L. ed. 210, 212). Obviously, a litigant, by choosing a wrong Court or a wrong remedy, cannot continue a litigation indefinitely when the statutes provide otherwise, as might be done if the time limit could be extended by selecting the wrong Court. If this could be done, the statute which limits the time would be a dead letter. (*Credit Co.* v. *Arkansas Cent. Rwy. Co.,* 128 U. S. 258, 261; *Conroy* v. *First National Bank,* 203 U. S. 141, 145; *Blaffer* v. *New Orleans*

Water Co., 160 Fed. (C. C. A.) 389). It is the date of the *decision* of the Court refusing the patent which is the controlling date (*Gandy* v. *Marble, supra*, pp. 439, 440).

In *Westinghouse Elec. Co.* v. *Ohio Brass Co.*, 186 Fed. 518, where proceedings for a patent under Sec. 4915 R. S. were first brought in the wrong district, and afterwards brought in the right district but not until more than one year had elapsed after the decision of the Court of Appeals of the District of Columbia, the Court dismissed the bill of complaint, and said:

> "Nor did the institution of proceedings within the year in the United States Circuit Court for the Western Division of the Northern District of Ohio satisfy the requirements of Sec. 4894. That requirement is to prosecute the application, and that presupposes that action be taken in the right tribunal and against the right party".

Mattullath Aeroplane Co. v. *Newton*, 1921 C. D. 103; 279 O. G. 730 (Supreme Court of District of Columbia, Gould, J., April 10, 1920), was an action under Section 4915 R. S., where the action was begun on February 23, 1918, and the *decision* of the Court of Appeals of the District of Columbia was rendered on February 5, 1917. Plaintiff's contention was "that by reason of having filed on February 21, 1917, a motion for reargument, which was denied on February 24, 1917, the year during which he might file his bill under Section 4915 did not begin to run until the latter date", that is, February 24, 1917, when the motion for reargument was denied. *In dismissing the complaint,* the Court said:

> "The contention of the plaintiff that the motion for reargument extended the time for appeal is answered by the decision of the Court of Appeals in *Ross* v. *Loewer* (9 App. D. C. 563) where it was held that a motion for rehearing does not suspend or extend the time for taking appeals from the Commissioner of Patents to that Court.

"In this case the patent was finally refused on February 5, 1917, by the Court of Appeals and this action not being brought within one year from that date as required by Section 4894, the motion to dismiss must be sustained". (See same case, 1921 C. D. 105 Hoehling, J., to same effect).

In *Colman* v. *American Co.*, 235 Fed. 531, 532, 537, the decision of the Court of Appeals of the District of Columbia was on June 3, 1913; the Supreme Court refused certiorari on Oct. 29, 1913; on February 24, 1914, the Commissioner gave to the applicant a formal notice that the case had been disposed of in accordance with the Court of Appeals' decision; the bill under Section 4915 was filed on Feb. 1, 1915. The Court held that the date of the decision of the Court of Appeals of the District of Columbia was the controlling date and that the formal notice by the Commissioner to the applicant on Feb. 24, 1914, was not the "action therein", which Sec. 4894 R. S. contemplated.

In re Hien, 166 U. S. 432, 438, 439, in adjudging that an appeal not taken in forty days to the Court of Appeals of the District of Columbia from a *decision* of the Commissioner of Patents was too late, the Court said:

"These proceedings, if they had been in time, amounted to the taking of an appeal, but as they were not initiated and prosecuted within the time limited they were ineffective".

When the time is limited by Act of Congress it is absolute when the right is strictly statutory. It is jurisdictional. (*The Bayonne*, 159 U. S. 687; *Stevens* vs. *Clark*, 62 Fed. (C. C. A.) 321; *Credit Company* vs. *Arkansas Cent. Rwy. Co.*, 128 U. S. 258).

In re McCall, 145 Fed. (C. C. A.) 898, 901, 902, which involved discharges under the Bankruptcy Act and appeals therefrom "within ten days after the judgment appealed from has been rendered", Lurton, J., said:

"The time limit upon the appeal from a judgment allowing or denying a discharge is 10 days and the language of the provision is 'that such appeal shall be taken *within ten days after the judgment appealed from has been rendered'*. The italics are ours (the Court's).

"Statutes which provide that writs of error or appeal shall be taken within a given time from the 'rendition' of the judgment or decree have been generally construed as stating the time limit from the date of the decision of the Court and not from the date of its subsequent entry in the Journal or signing by the Judge."

Rules or orders of the Courts do not enlarge the time limited by Acts of Congress, *Conroy* v. *First National Bank*, 203 U. S. 141, 145; *Credit Co.* v. *Arkansas Cent. Rwy.*, 128 U. S. 258; *United States* v. *Fidelity & Deposit Co.*, 155 Fed. (C. C. A.) 117.

In *Arnson* v. *Murphy*, 109 U. S. 238, 243, which was a suit to recover duties erroneously exacted, the Court held that Congress had regulated the matter

"by express statutory provision. And among them are the conditions which fix the time when the suit may begin, and prescribe the period at the end of which the right to sue shall cease. Congress having undertaken to regulate the whole subject, its legislation is necessarily exclusive".

The record at bar shows that the decision and decree of the Court of Appeals of the District of Columbia were made and entered March 3, 1919, (Rec. pp. 65, 66). The complaint in this action was filed May 7, 1921 (Rec. p. 11), more than two years and two months after the date of the decree in the Patent Office proceeding.

"Upon a writ of error, or appeal, the transcript from the records of the lower Court imparts absolute verity,

and it is not competent to contradict or extend the recital of the record by evidence dehors the record". *In re McCall,* 145 Fed. 898, 902.

As an action under Sec. 4915 R. S. is "a part of the application for a patent" (*Am. Steel Foundries Co.* v. *Robertson,* 262 U. S. 209) it is governed by the rules applicable thereto.

The time to take appeals from the Patent Office to the Court of Appeals of the District of Columbia (40 days) is strictly enforced (*Burton* v. *Bently,* 14 App. D. C. 471; *Ross* v. *Loewer,* 9 App. D. C. 563; *In re Hien,* 166 U. S. 432). Time is reckoned from the date of the *decision* of the Court of Appeals of the District of Columbia and *not* from the time that notice of the decision is sent to, or received by, the party against whom made (*Burton* v. *Bentley, supra*) and the running of the time is not suspended by filing a petition for a rehearing. (*Ross* v. *Loewer,* 9 App. D. C. 563).

V.

Jurisdiction is Wanting Because Appellant's Claim of Right and that it is being Deprived of Property "Without Due Process of Law" is Without Color of Merit.

Respondent contends that the claim set forth in the Complaint is so unsubstantial as to be plainly without color of merit, and for that reason jurisdiction is wanting.

In *Merriam Co.* v. *Syndicate Pub. Co.,* 237 U. S. 618, 621, an action for infringement of a registered trade-mark consisting of the personal name "Webster", it was held that if jurisdiction is invoked on a claim of right arising under the constitution or statute which is

> "unsubstantial and without real merit, either because of its frivolous character upon its face, or from the fact

that reliance was based upon a claim of Federal or statutory right denied by former adjudications of this Court, then the appeal to this Court must be dismissed".

Brolan v. *United States*, 236 U. S. 216;
de Bearn v. *Safe Deposit Co. of Baltimore*, 233 U. S. 24;
Equitable Life Ins. Co. v. *Brown*, 187 U. S. 308, 311, 315.

To determine appellant's constitutional claim that it is about to be deprived of property without due process of law, it is necessary to consider the nature and basis of appellant's claim of right, for if the claim is a mere allegation, without color of merit, the action should forthwith be dismissed for want of jurisdiction. *United States* v. *Am. Bell Co.*, 159 U. S. 546, 554. All constitutional rights depend upon what the facts are. (*Prentis* v. *Atlantic Coast Line*, 211 U. S. 210, 228).

Jurisdiction, as this Court has not infrequently said, must often be determined upon consideration of the nature of the case and the grounds upon which jurisdiction is invoked, and this Court may decide questions of merits so far as they bear upon the question of whether the trial Court has or had not jurisdiction.

Brown vs. *Lane*, 232 U. S. 598, 600;
St. Joseph & Grand Island Ry. Co. v. *Steele*, 167 U. S. 659, 662.

The bill of complaint, stripped of its surplusage, is reduced to a single claimed right, and that claimed right is the right to have a common personal name (Howard) registered as a trade-mark under the Trade-Mark Laws. As such a "right" has been repeatedly denied and positively foreclosed by this Court, such a claim obviously cannot be the basis for an injunction, or for any relief.

Howe Scale Co. v. *Wyckoff etc.*, 198 U. S. 118; *Merriam Co.* v. *Syndicate Pub. Co.*, 237 U. S. 618, and cases cited.

The matter in dispute is not the right to the name "Howard" as a name for a piano, but the "right" to have it registered.

> "But the only question we have, or can have, presently before us, is the right to register, 'not the value or worthlessness of what is registered' ". *Hercules Powder Co.* v. *Newton, Commissioner*, 266 Fed. (C. C. A.) 169, 171.

A suit based upon a claim which has been foreclosed is manifestly frivolous. *Equitable Life Ins. Co.* v. *Brown*, 187 U. S. 308, 311, 315.

The "ten-year" clause of Sec. 5 of the Trade-Mark Act of 1905 (33 Stat. 724 et. seq.) is not involved here because appellant does not claim use for the requisite ten-year period; appellant does not claim use prior to December 15, 1896. (Complaint, par. 3, Rec. p. 2).

A mark is not registrable unless its controlling or dominant features are registrable. A non-registrable name, word or term does not become registrable by combining it with registrable subject-matter; non-registrable matter must be disclaimed.

> *Beckwith* v. *Commissioner of Patents*, 252 U. S. 538, 541.

If the mark was incapable of exclusive appropriation when adopted, or when registered, the question of priority of use is immaterial. *The statutory prohibition relates back to the date of adoption.* (Sec. 1 and 2 of both Trade-Mark Acts).

Appellant's claim that "Howard" is Printed in a "Particular" or "Distinctive" Manner is Wholly Without Merit.

Nothing is added to the force or effect of appellant's contentions by its pretence that this personal name "Howard", as registered, is printed in a "particular and distinctive manner". The "particular or distinctive" proviso of Section 5 of the Trade-Mark Act of 1905 (c. 592, 33 Stat. 724 et seq.), on which appellant appears to rely, reads:

> "*Provided*, that no mark which consists merely in the name of an individual, firm, corporation, or association not written, printed, impressed or woven in some particular or distinctive manner, * * * shall be registered under the terms of this Act;"

What the First Registration Shows.

As all provisions respecting registration of trade-marks are statutory, it should be noted that this earlier registration was made under the Trade-Mark Act of 1881 (c. 138, 21 Stat. 502, et. seq.), which contained no provision for registering a mark printed in a "particular" or "distinctive" manner; such a registration was first authorized by the Trade-Mark Act of 1905.

Section 2 of the Trade-Mark Act of 1881 reads as follows:

> "Section 2.—That the application prescribed in the foregoing section must, in order to create any right whatever in favor of the party filing it, be, accompanied by a written declaration verified by the person, or by a member of a firm, or by an officer of a corporation applying, to the effect that such party has at the time a right to the use of the trademark sought to be registered, and that no other person, firm or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as might be calculated to

deceive, that such trademark is used in commerce with foreign nations or Indian tribes, as above indicated, and that the description and fac-similes presented for registry truly represent the mark sought to be registered".

Thus, the Trade-Mark Act of 1881 expressly required, *as a prerequisite to a valid registration,* that the applicant must be the owner (Sec. 1),

> "That the application * * * must, in order to create any right whatever in favor of the party filing it, be accompanied by a written declaration verified * * * that such trademark is used in commerce with foreign nations or Indian tribes, as above indicated, and that the description and fac-similes presented for registry truly represent the mark sought to be registered".
>
> *Elgin Watch Co.* v. *Ill. Watchcase Co.,* 179 U. S. 665, 671.

The earlier registration (Rec. pp. 53-r, 53-s) contains the verified declaration and statement of applicant's president submitted to the Patent Office as the basis for registration, which set forth (Rec. p. 53-s) that the trade-mark

> "consists of the word 'Howard' in connection with the initials 'VGPCo.' in the form of a monogram".

and, continuing, stated:

> "the form of lettering of 'Howard' may be differently arranged without materially altering the character of the trade-mark, the principal feature of which is the word 'Howard' in connection with the initials 'VGPCo.' arranged monogrammatically".

It is respectfully submitted that this affidavit and statement of registrant's president, forming the basis for the registration itself, positively and conclusively controverts appellant's

claim that the name "Howard" was printed, claimed or registered in a "particular" or "distinctive" manner; in fact, the registration record itself renders such a claim positively without merit.

In *A. Leschen Rope Co.* v. *Broderick Co.*, 134 Fed. (C.C.A.) 571, 572, 573; 201 U. S. 166, 170, 171, the main questions involved were (1) What was adopted?; (2) Was what was adopted distinctive? All the Courts held that what was adopted was shown by what was declared in registrants' statement for registration, and not what they may have used, and held that what was declared was "too indefinite to be the subject of a valid trade-mark". The application to register (under Act of 1881) described the mark as consisting

> "of a red or distinctively colored streak applied to or woven in a wire rope".
>
> "The essential feature of the trade-mark is the streak of distinctive color produced in or applied to a wire rope". • • •
>
> "This mark is usually applied by painting one strand of the rope a distinctive color, usually red".

The drawing and the exhibits furnished showed one strand red.

The Circuit Court of Appeals (Circuit Judge Vandeventor sitting) quoted from *Smith* v. *Reynold*, 10 Blatch. 85, and said (p. 572):

> "Their registration must stand or fall as a whole, for that to which they declare in their registration they intend to appropriate". And at p. 573:
>
> "It is quite likely that they have confined themselves to a distinctive color of one of the several strands of the rope. This, however, is not the language in which their claim is embodied in the statement filed with the Commissioner of Patents, and the Court is compelled to look to that statement, rather than to the manufacture, for we are not dealing with a common-law trade-mark, based

upon use, but a trade-mark claimed and described in a written statement".

This Court (201 U. S. 166, 170, 171) unanimously affirmed the Courts below, using, in substance, their language, and said:

> "the trade-mark must stand or fall in its entirety, and if the description therein be too broad, it cannot be sustained by showing that defendant imitated its color and its method of applying it". It is the description "which would be answered by a streak of any color", which "was held by both Courts, and we think properly, too indefinite to be the subject of a valid trade-mark".

The Court's consideration is particularly requested to the *whole* of the masterly opinion in ***Ex parte Engelhard & Sons Co.***, 1904 C. D., 122, 124, 125, which was to register "Engelhard" printed on a cloud-bank in script letters "arranged on a line ascending from the left to the right, and a stroke, beginning at the letter 'd', drawn at an angle to the line on which the letters are arranged and terminating in a curve. * * * On the light side of the letters, a white border and on the shaded side a dark border is provided". Commissioner Allen said:

> "If the mere name printed in the ordinary way would create so nearly the impression created by the mark as to render the user of the mere name an infringer, then to protect this mark as a trade-mark would be to protect the mere name, to which the statute expressly refuses protection. If accessories are to save the mere name from the inhibition of the statute they must rise into such relative importance and must so dwarf the mere name as to render this latter of minor importance in the whole effect produced upon the mind of the observer and to prevent such result of infringement as just mentioned. In fact, it seems to me that a due regard to the spirit of

the statute requires the reduction of the name element in the mark to be carried so far that the name becomes a negligible or non-essential factor in the whole effect produced, so that if the rest of the mark should remain and the name should be changed it would not present a substantially different appearance". * * *

"It must be a rare case—one in which the elements are blended with unusual skill—when the name can be said to enter into the effect produced by the mark and not constitute a mere label upon it".

In *Ex parte Haines Knitting Co.*, 1913 C. D 205, Commissioner Moore cited *Ex parte Engelhard & Sons Co., supra,* and quoted with approval most of the above excerpt as applicable to the Trade-Mark Act of 1905.

As there was no direct review, judicial or administrative, by appeal or otherwise, of decisions of the Commissioner of Patents upon applications to register trade-marks under the Trade-Mark Act of 1881 (*So. Carolina* v. *Seymour,* 153 U. S. 353, 355) only opinions of the Commissioner can be cited.

What the second registration record shows.

The Record contains a photographic copy of the entire file of the Patent Office pertaining to the later registration. (Rec. pp. 53-a to 53-q).

Section 2 of the Trade-Mark Act of 1905 reads as follows:

"Sec. 2. That the application prescribed in the foregoing section, in order to create any right whatever in favor of the party filing it, must be accompanied by a written declaration verified by the applicant, or by a member of the firm or an officer of the corporation or association applying, to the effect that the applicant believes himself or the firm, corporation, or association in whose behalf he makes the application to be the owner of the trade-mark sought to be registered, and that no

other person, firm or corporation, or association, to the best of the applicant's knowledge and belief, has the right to use such trade-mark in the United States, either in the identical form or in such near resemblance thereto as might be calculated to deceive; that such trade-mark is used in commerce among the several States, or with foreign nations, or with Indian tribes, and that the description and drawing presented truly represent the trade-mark sought to be registered. * * *"

Thus, the Trade-Mark Act of 1905 also expressly requires, *as a prerequisite to a valid registration,* "in order to create any right whatever", that the applicant must be the owner, that the application must be accompanied by a verified declaration

"that such trade-mark is used in commerce among the several States, or with foreign nations, or with Indian tribes, and that the description and drawing presented truly represent the trade-mark sought to be registered."

In applying to register the later registration, appellant submitted as the basis for the registration the verified declaration and statement of its president which set forth the following (Rec. p. 53-a):

"The trade-mark sought to be protected * * * is shown in the accompanying drawing and consists of the arbitrary word 'Howard' in conjunction with the initials 'VGPCo.' in the form of a monogram".

and, continuing, stated:

"and the form of lettering of 'Howard' may be differently arranged without materially altering the character of the trade-mark, the principal feature of which is the word 'Howard'.

The drawing filed with this affidavit *was a fac-simile of the drawing of the earlier application,* and this drawing is repro-

duced on page 53-o of the record. Nothing could be more conclusive than this sworn statement of appellant's president to establish that the name "Howard" *was not adopted* or claimed to be printed in a "particular" or "distinctive" manner.

About two months after the application was filed, the drawing was changed to that which now appears in the registration, and during the same period the statement and description of the mark was changed and modified several times before it reached the form appearing in the registration, but *no new declaration was filed* and no proof whatever was offered to the Patent Office (as the Patent Office file shows) that the mark as shown in this later registration was ever used by appellant or any predecessor in business. Consequently, the registration was wholly unauthorized in law and was made in face of the positive prohibition of the Trade-Mark Act, as plainly appears from the application file itself. *Ex parte Newman*, C. D. 1910, 194; *Ex parte Felton, etc.*, C. D. 1910, 7. See also the following Patent Office Rules:

Rules 33 and 39 of the Patent Office governing the registration of Trade-Marks, effective April 1, 1905, read as follows:

> "33. Amendment of the declaration will not be permitted. If that filed with the application be faulty or defective, a substitute declaration must be filed".
>
> "39. The statement may be amended to correct informalities, or to avoid objections made by the office, or for other reasons arising in the course of examination, but no amendments to the description or drawing of the trade-mark will be permitted unless warranted by something in the specimens (or facsimiles) as originally filed".

Patent Office Rule 33 is now Rule 35 and Rule 39 is now Rule 41, but there has been no change in their language since their adoption April 1, 1905.

"Howard" in the Second Registration is not Printed in a "Particular" or "Distinctive" Manner.

The drawing of the second registration speaks for itself. Does it signify "Howard", is the name "Howard" the striking feature, or does it signify something "particular" or "distinctive"? What impression would it convey to the mind of the "ordinary observer", for "the law is not made for the protection of experts, but for the public,—the vast multitude which includes the ignorant, the unthinking and the credulous". (*Florence Mfg. Co.* v. *Dowd*, 178 Fed. (C.C.A.) 73). What will it signify to people in foreign countries? Does the form of the lettering make it the arbitrary sign of something else than the personal name "Howard"? If not, it is unregistrable.

Is it "particular" or "distinctive" in the sense that it could not "cause confusion" with "Howard" in script letters, for example, or, in fact, with "Howard" in almost any form of common lettering? If not, it is unregistrable.

A glance at the drawings of the two Registrations shows a different form of lettering of the name "Howard". Furthermore, a comparison of these marks with the marks reproduced on pages 42-d and 42-f of the record (which marks appellant claims to have used since 1912), shows further differences in the form of lettering of "Howard".

Now these four marks are all the same, and signify nothing except the personal name "Howard", or they are different.

If appellant claims that they are all the same, that the second Registration is the same as the first, and that the other two marks are not only like each other, but that both are the same as the two marks shown in the Registrations, it must follow that there is nothing of the "particular" or "distinctive" attained by the different forms of lettering used by appellant, in which case appellant would be claiming "Old English" in any style and every style if slightly twisted, flourished, curved or slanted, and some other trader could

claim "script", and some other "block" lettering, and so on.

But if appellant claims that the four marks are different, each from the others, then the mark in the second Registration is a different mark from that covered by the first Registration, and *the second Registration cannot be based upon the use of the mark in the first Registration.* Under such a claim, the other two marks are not only different from each other, but also different from both of the marks in the Registrations, and it follows that the two marks *not* registered might have been adopted and registered by other traders and would not interfere with appellant's Registrations; that is, if the contention is that all are different, all four marks are registrable as "particularly and distinctively" printed.

If four marks could thus be appropriated and registered, why not forty, or four hundred, for there are over one hundred "Howard" individuals listed in the Washington Telephone Directory and printers are easily found who could put a different twist to the lettering, or add a different flourish, curve, or slant, and no one of these marks would infringe any of the others or

> "be likely to cause confusion or mistake in the mind of the public". (Sec. 5, Trade-Mark Act of 1905).

In *A. Leschen Rope Co.* v. *Broderick Co.,* 134 Fed. (C. C. A.) 571, 572, 573, the Court held that if any color could be taken as a trade-mark it would be without value unless it could be varied, and

> "a right to vary the color indefinitely would destroy that distinctive character which must inhere in a valid trade-mark".

The same, in substance, was said by this Court, in the same case (201 U. S. 166, 170); it is respectfully submitted that *the same principle holds as to varying the lettering of "Howard".*

In the Equity Action, *The Baldwin Co.* v. *R. S. Howard Co.,* 233 Fed. 439, the Court referred to the hundreds of pianos

bearing the name "Howard" made and sold PRIOR to 1896, the date appellant claims that it or any of its predecessors first used "Howard", and the Court said (Rec. p. 47):

> "There is no doubt that from the time any variant of 'Howard' was inscribed upon pianos the retail trade, the user, and the public generally spoke of them as 'Howard' pianos."

In *Mansfield Tire Co.* v. *Ford Motor Co.*, 44 App. D. C. 205, 206, which involved an application to register "Ford", which applicant claimed was displayed in a "particular" and "distinctive" manner, the Court, affirming the Patent Office refusing registration, said:

> "Whether the word is to be written or printed in a peculiar manner is of no consequence, for however it is written, the letters will spell 'Ford' and the domain of the appellee will be encroached upon".

In *Oliver Plow Works* vs. *Wm. J. Oliver Mfg. Co.*, 40 App. D. C. 125, 128, 129, the opinion contained a reproduction of the mark which consisted of a large "O" in the center of which is a "V", on top and to the left of the "V" are the letters "li", to the bottom and to the right of the "V" are the letters "er", and over the top of the "O" is "The Wm. J." The registration was refused, the Court holding that the mark was not "particularly" or "distinctively" displayed within the meaning of the Trade-Mark Act, repeated previous rulings, and *formulated the test,* which has ever since been followed by that Court and other Courts, in the interpretation of the "particular" and "distinctive" proviso of Sec. 5 of the Trade-Mark Act of 1905, and said:

> "It is believed that the controlling principle underlying the requirement of the statute that a mere name unless written in a distinctive manner, may not be registered, is that the distinctive manner in which the name is displayed must be of a character as to give such a dis-

tinctive impression to the eye of the ordinary observer as to outweigh the significance of the mere name".

In *Johns-Manville Co.* v. *Am. Steam Packing Co.*, 33 App. D. C. 224, the mark was the word "Asbestos" printed in an embellished manner, the letters appearing as if formed of asbestos fiber; registration was refused, the Court saying:

"the predominating characteristics of appellant's mark is the same word (asbestos), merely in embellished letters. * * *

"The impression given one who sees it on the goods must be that they are to be identified by the word 'Asbestos', and not by the shape of the letters representing it". * * *

"Peculiarities in printing cannot lend trade-mark properties to an otherwise unregistrable descriptive word (or personal name). If it were otherwise, an unregistrable non-technical word could be appropriated and registered as a trade-mark as many times as the form of its printing could be varied".

In *Tinker* v. *Patterson Dental Supply Co.*, 287 Fed. 1014, the mark consisted of the name "Tinker", with a large "T" to the left of which were the letters "in" in much smaller letters and to the right of which were the letters "ker" in letters similar in size to those on the left, and was registered for a dental composition known as "Tinker's Gold" originally prepared by Dr. Tinker and donated to the dental profession. The Court held that the mark was not "particularly" or "distinctively" displayed, "it was not sufficiently distinguished", within the meaning of the Trade-Mark Act, and this registration was cancelled.

In *DuPont* v. *Ginter Co.*, C. D. 1921, 79, the mark sought to be registered "consists of the words 'DuPont' above a fanciful design resembling a coat-of-arms on which are the letters 'DP'." The registration was refused because

"it seems clear that 'the mark under consideration presents an appearance so little modified from the name used alone as to make the modification comparatively insignificant'. * * * it is admitted in the opposition papers that the opposer has not applied the mark to any goods; but under the clear words of Section 5 of the statute it would seem that the name is not registrable, irrespective of use. (Citing *Mansfield Tire & Rubber Co.* v. *Ford Motor Co.*, 44 App. D. C. 205, and *Ex parte A. Engelhard & Sons Co.*, 109 O. G. 1886; 1904 C. D. 122).

"It may be that applicant has the common law right to its mark, but it cannot be registered under the statute".

In re Artesian Mfg. Co., 37 App. D. C. 113, the mark consisted "of the words 'Deacon Brown' printed in script type, with a scroll extending across all of the letters except the 'D', and having the letters 'D' and 'B' connected across the top by two 'flourishes'." This mark was held *not registrable* as it was the name of an individual and not printed in a "particular" or "distinctive" manner within the meaning of the Trade-Mark Act.

In *Ex parte Pittsburgh Valve Foundry Co.*, C. D. 1907, 137, the mark consisted of the word "Atwood" associated with a large arrowhead and the letter "A"; held *not registrable* because "the name 'Atwood' is a predominating feature of the mark * * *. The association with the name, of the fanciful symbol is not considered sufficient to render the mark registrable as a whole".

In *Ex parte Mills & Gibbs*, C. D. 1913, 164, the mark consisted of the name "Longfellow, which is a name commonly found in City directories", written in script, arranged in a curved line and enclosed in quotation marks. The Commissioner said:

"Writing the mark in script type, in a curved line, and enclosing it in quotation marks is not such a par-

ticular or distinctive manner of displaying the same as would justify registration".

In *Morgan Drug Co.* v. *Palmer,* 13 T. M. Rep. 479 (Nov. 5/23) the mark was "Palmer" written in script, said to be in the handwriting of registrant (but not his signature). Held, registration should be cancelled on the ground that the mark is merely a name and is not written in a particular or distinctive manner.

In *Ex parte Kellogg Toasted Corn Flake Co.,* (5 T. M. Rep. 428) where "Kellogg" was printed in a so-called "emphasized signature" it was held not registrable although it may have been in the handwriting of an individual.

In *Dunlop & Co.* v. *The Jackson & Gutman Co.* (Jan. 9, 23) 13 T. M. Rep. 66, 67, the mark consisted of "Dunlop" in block type, printed so that there is a slight reduction in the height of the letters toward the middle of the word, surrounded by an outline of substantially upright ends, a downward curved top and upward curved bottom", claimed to be distinctively displayed. Held, not distinctively displayed, the Ass't Commissioner saying:

> "It seems clear that any reasonable interpretation of the language of the 1905 statute would preclude the registration of the present mark. To say that by placing a border of simple lines about a name removes it from being merely a name seems an unreasonable bending of common sense."

In *Ex parte The Rainier Co.,* C. D. 1907, 168, it was held that the word "Rainier" written in "large script letters with a flourish extending from the letter 'R' beneath certain letters of the word" is not such a distinctive display of the same as is required by the Trade-Mark Act.

In *Ex parte United States Brewing Company,* C. D. 1906, 437, it was held that a family name printed in script on a diagonal line, the letters being shaded so as to appear in per-

spective and with a paraph under the word, is *not* such a distinctive display as to justify registration.

In *Ex parte Alden Co.*, C. D. 1907, 423, the mark comprised the words "The Alden Shoe", enclosed within a circle together with some descriptive matter, the letters of the word "Alden" were

> "of different size, so that the word 'Alden' has the general form of an ellipse. The real question to be determined is this case is whether the word 'Alden' is printed in such a distinctive manner as to warrant registration under the provisions of Section 5 of the Act of 1905, above noted".

Registration was refused, the Court holding that

> "The peculiarities must dominate the mere name and reduce it to a position of relative obscurity".

In *Ex parte Churchill* v. *Alden Co.*, 120 Mis. Dec. 34, the mark consisted of the name "Farnam", the "F" of which was in large script, shaded, and the other letters in similar script shaded. Held: not distinctively displayed.

In *Ex parte O'Bannon Corporation*, 123 Mis. Dec. 82, May 25, 1917, the mark consisted of the name "O'Bannon" over and above the word "Moleskin", marking a general oval figure, with a heavy dash under the middle of the bottom word. This mark held not "distinctively" displayed and *registration refused.*

In *Ex parte Morton Samuels*, 121 Mis. Dec. 169, Dec. 6, 1916, the mark consisted of "New-ark" in large brush letters with the words "Save a Dollar" above in small light black letters. *Registration refused* as the mark was not "particularly" or "distinctively" displayed within the meaning of the Trade-Mark Act.

In *Ex parte Sunderland*, 120 Mis. Dec. 441, the mark consisted of the name "Fisher" in heavy round script. Held not "distinctively" displayed and *not registrable.*

In *Ex parte S. F. Bowser & Co.*, 117 Mis. Dec. 340, the mark consisted of the name "Bowser", the letters being connected at the top and bottom by a line, the letters being shorter at the end than in the middle. Held not "distinctively" displayed and *registration refused.*

In *Fairmount Mining Machine Co.*, 120 Misc. Dec. 388, the mark consisted of the word "Fairmount" displayed with the "F" and the "T" abnormally large and connected with a bar at the top. *Held: not registrable.*

In *Heath* v. *Wallace*, 138 U. S. 573, 582, the Court said:

> "the construction given to a statute by those charged with its execution of it is always entitled to the most respectful consideration, and ought not to be overruled without cogent reasons."

Bate Refrigerator Co. v. *Sulzberger*, 157 U. S. 136.
National Lead Co. v. *United States*, 252 U. S. 140.
United States v. *Hermanos & Co.*, 209 U. S. 337, 339.

The Fifth Amendment does not apply.

The Court of Appeals of the District of Columbia, (a "special tribunal entrusted with full power in the premises" (*Morgan* v. *Daniels*, 153 U. S. 120. 124), "a Court of high authority endowed with all machinery of Superior Courts of Jurisdiction" (*Greenwood* v. *Dover*, 194 Fed. (C. C. A.) 90, 94) has adjudged, after full review upon a record covering nearly three thousand pages, that the two registrations here involved should be cancelled. Every allegation made at bar was there made, urged and *determined.*

In *Ballard* v. *Hunter*, 204 U. S. 241, 255, this Court, in determining "due process", said:

> "Its fundamental requirement is an opportunity for a hearing and defense, but no fixed procedure is demanded. The process or proceeding may be adapted to the nature of the case. (cases cited) * * * and if found

to be suitable or admissible in the special case it will be adjudged to be 'due process of law', but if found to be arbitrary, oppressive and unjust it may be declared to be not 'due process of law', * * * Errors or irregularities in the suit do not take from it or its decree the attribute of due process". *Central Land Co.* v. *Laidley*, 159 U. S. 103, 112; *Iowa Central R. R. Co.* v. *Iowa*, 160 U. S. 389, 393.

Whether a property right is to be taken away without "due process of law" depends, at the outset, upon the existence of the property right and if it is obvious that no property right exists, the constitutional claim is a mere pretense and, in effect, no claim at all.

In *United Surety Co.* v. *Am. Fruit Co.*, 238 U. S. 140, the Court said, where

> "The constitutional point is a mere pretext put forward in order to open other questions that otherwise could not come here. That pretext is not allowed to succeed. *Goodrich* v. *Ferris*, 214 U. S. 71, 79".

A registrant cannot be deprived, in a legal sense, of the benefit of registrations, or be damaged by the cancellation of registrations, if the registration were unlawfully obtained or obtained without authority of law, as is self evident. A "right" which legally never existed cannot be taken away.

Something cannot be made out of nothing, and that which is void *ab initio* cannot be made the basis of a valid Constitutional claim.

There is no vested right, or vested right of property, in a Trade-Mark Registration. The registration of a Trade-Mark creates no new right or title.

Trade-Mark Cases, 100 U. S. 82, 92, 93;
Elgin Watch Co. v. *Illinois Watchcase Co.*, 179 U. S. 665;
United Drug Co. v. *Theo. Rectanus Co.*, 248 U. S. 90;
Merrian Co. v. *Syndicate Pub. Co.*, 237 U. S. 618;

Hanover Star Milling Co. v. *Metcalf*, 240 U. S. 403;
Stephano Bros. v. *Stamatopoulos*, 238 Fed. (C. C. A.) 89, 91;
Walders v. *International Mfg. Agency*, 237 Fed. (C. C. A.) 502, 506;
Aunt Jemima Mills Co. v. *Rigney*, 247 Fed. (C. C. A.) 407, 409.

Chief Justice Fuller, speaking for this Court in *Howe Scale Co.* v. *Wyckoff, Seamans & Benedict*, 198 U. S. 118, 134, said:

> "As the name 'Remington' is an ordinary family surname, it was manifestly incapable of exclusive appropriation as a valid trade-mark, and its registration as such could not in itself give it validity".

In *Elgin Watch Co.* v. *Illinois Watchcase Co.*, 179 U. S. 665, 672, this Court said:

> "the benefits of the Act cannot be availed of if the alleged trade-mark is not susceptible of exclusive ownership as such, and not, therefore, of registration".

In *Ex parte Edwin C. Burt Co.*, 1901 C. D. 108, wherein applicant and its predecessor had used "Burt" since 1860, Commissioner Moore in refusing registration said:

> "A technical trade-mark is essentially a vested right. A proper name is not a technical trade-mark for the very reason that in the nature of things it never was and never can be a vested right. It belongs equally to all persons bearing that name. This doctrine was as well settled prior to 1881 as it is at the present time".

In *United Drug Co.* v. *Rectanus Co.*, 248 U. S. 90, 97, this Court said:

> "It is not contended, nor is there ground for the contention, that registration of the Regis trade-mark under

either the Massachusetts statute or the Act of Congress, or both, had the effect of enlarging the rights of Mrs. Regis or of petitioner beyond what they would be under common-law principles."

In *Sarrazin* v. *Irby Cigar Co.*, 93 Fed. (C. C. A.) 624, 626-628, the Court said:

> "Secs. 10 and 11 of the Act (of 1881) make it as clear as possible that the Act does not in any manner 'prevent, lessen, impeach or avoid' any remedy or right, or 'unfavorably affect any claim to a mark' either before registry, after registry, or even after the term of registry has expired".
>
> "The registration of a trade-mark under this law adds nothing to the right of ownership therein and takes nothing away from such ownership."

The right of property in a trade-mark is gained by adoption and use and not by registration. If the trade-mark is *registrable* and registered, "the method of proof differs, the tribunal which passes upon the right may differ, and the form of relief may differ. The essential right, however, is the same". *Loughran* v. *Quaker City Chocolate Co.*, 286 Fed. 694, 698; *Columbia Mill Co.* v. *Alcorn*, 150 U. S. 460.

In *Given* v. *New York Athletic Club*, 42 App. D. C. 558, 559, the Court said:

> "In *Einstein* v. *Sawhill*, 2 App. D. C. 10, it was pointed out that the trade-mark Act creates no rights in the mark registered, but merely provides evidence of the ownership of the right. This we have repeatedly emphasized since."

Registration is a privilege for the encouragement of industry and is purely voluntary on both sides; there is no pledge or duty that the registration Act will not be repealed and it is subject to repeal at any time as is a tariff or drawback

provision for the protection of certain manufactures. It depends solely upon the discretion of Congress. *Salt Company* v. *East Saginaw,* 13 Wall. 373; *Welch* v. *Cook,* 97 U. S. 541; *Grand Lodge* v. *New Orleans,* 166 U. S. 143, 147, and cases cited.

As no vested right is created by the registration, no constitutional right can be impaired by its cancellation.

In *Kline* v. *Burke Const. Co.,* 260 U. S. 226, 234, the Court said:

> "A right which thus comes into existence only by virtue of an Act of Congress, and which may be withdrawn by an Act of Congress after its exercise has begun, cannot well be described as a constitutional right".

In *Excelsior Wooden Pipe Co.* v. *Pacific Bridge Co.,* 185 U. S. 282, 287, the Court said:

> "In *Robinson* v. *Anderson,* 121 U. S. 522, it was held that when it appeared, after all the pleadings were filed, that the averments in the declaration which alone gave the Court jurisdiction, were immaterial and made for the purpose of creating a case cognizable by the Court, it was the duty of the Circuit Court to dismiss the bill for want of jurisdiction".

In *Brown* v. *Lane,* 232 U. S. 598, 600, where jurisdiction was claimed because "involving the construction or application of the Constitution of the United States", this Court said:

> "But it is elementary that where the jurisdiction depends upon the presence of controversies of a particular character or the existence of prescribed questions or conditions, substance and not mere form is the test of power and therefore even in a case when the requisite for jurisdiction formally exists the right to review does not obtain when it is evident that the formal questions presented by the record are so wanting in substance as

to cause them to be frivolous and devoid of all merit. *Consolidated Turnpike Co.* v. *Norfolk &c. Ry Co.*, 228 U. S. 596, 600, and cases cited".

When the federal question is so unsubstantial as not to require argument, motion to affirm or dismiss should be granted. *Milheim* v. *Moffat Tunnel Dist.*, 262 U. S. 710, 716, 717.

Jurisdiction cannot be conferred by mere allegations or by argumentative statements. *Shulthis* v. *McDougal*, 225 U. S. 561, 569; *St. Joseph & Grand Island Ry. Co.* v. *Steele*, 167 U. S. 659, 662; *Hanford* v. *Davies*, 163 U. S. 273, 279; *Sarragen* v. *Irby Cigar & Tob. Co.*, 93 Fed. (C. C. A.) 624.

The claim that the Fifth Amendment to the Constitution is to be violated is obviously without merit.

VI.

Appellant's Claim Under the "Full Faith and Credit" Clause of the Constitution Is Wholly Without Merit.

This claim is made in par. 8 of the Complaint (Rec. p 6) on the ground that the Court of Appeals of the District of Columbia failed to give full faith and credit to the decree in a former Equity Action in the Second Circuit between the same parties.

The decree in that action is pleaded at bar and the Complaint contains several allegations respecting that Action (Complaint, pars. 7, 8, 10, Rec. pp. 4-8).

The record of said former Equity Action (*The Baldwin Co* vs. *R. S. Howard Co.*, 233 Fed. 439; 238 Fed. 154; 243 U. S 636) is a part of the records of this Court (No. 916 October Term 1916), and was included in the Cancellation record

submitted in support of the motion to dismiss the complaint at bar.

Said former Equity Action of *The Baldwin Company* vs. *R. S. Howard Company* involved three separate and distinct issues:

First issue in the Equity Action.

For infringement of the said two registered trade-marks, No. 31,411 and No. 46,993, at bar, praying for three-fold damages for their infringement. The Baldwin Company withdrew this issue at final hearing and there was no adjudication respecting it. The Court of Appeals, in its opinion, said (Rec. p. 53):

> "At the final hearing below, plaintiff did not claim infringement of its registrations and confined its charge of infringement solely to its common law right in the name 'Howard', * * *".

Second issue in the Equity Action.

To enjoin unfair trade competition based on appellant's common law right to the name "Howard" as a name for a piano. Both Courts based their decisions "solely to its common law rights", decreeing that the Baldwin Company had the right to use "Howard", *simpliciter,* as a name for its pianos, and that the R. S. Howard Company had the right to use "Howard" with the prefix "R. S." or "Robert S." and the suffix "Company" or "Co.", on its pianos and as its business and corporate name (Rec. pp. 4, 5).

It may be noted that in the decree (Rec. pp. 4, 5,) the word "mark" or "trade-mark" does *not* appear.

The Federal Courts have repeatedly held that decisions "confined solely to questions of unfair competition" are "a matter of no concern * * * either by way of estoppel or otherwise" in actions or proceedings relative to trade-mark regis-

trations. The case of *Hercules Powder Co.* v. *Newton, Commissioner,* 266 Fed. (C. C. A.) 169, and the many cases therein cited, thoroughly covers this point, the opinion in that case being written by the same Judge who decided the Baldwin-Howard former Equity Action in the District Court in New York.

The distinction is clearly shown in *Standard Paint Co.* v. *Trinidad Asphalt Co.,* 220 U. S. 446.

In *Hercules Powder Co.* v. *Newton, supra,* which was an action to register a trade-mark under Sec. 4915 R. S., the Court said (pp. 170, 171):

> "Plaintiff has, we think, sought to complicate the issue by pressing upon us as a fact proven beyond doubt, that dealers and buyers of powder do not associate 'Infallible' with that explosive except as indicative of its origin—'Infallible' means made by Hercules Co.
>
> * * *
>
> "The Commissioner cannot base approval or denial of application on an inquiry into the nature of petitioner's business, or a finding as to how the public regards the product thereof; he can but examine the article and the mark, and declare whether the statute prohibits their registered union.
>
> "Therefore, the evidence offered by plaintiff (as to its common law rights, for protection against unfair trade, the extent and value of its business or good-will, etc.) is immaterial, and we regard the case as presenting nothing but an inquiry as to the meaning of a statute".

In *Elgin Watch Co.* v. *Illinois Watchcase Co.,* 179 U. S. 665, 677, the distinction between an unfair trade action and an action for the infringement of a registered trade-mark is plainly shown; the Court said:

> "In the instance of a lawfully registered trade-mark, the fact of its use by another creates a cause of action. In the instance of the use in bad faith of a sign not in

itself susceptible of being a valid mark but so employed as to have acquired a secondary meaning, the whole matter lies *in pais.*

"It is to be observed, however, that the question we are considering is not whether this record makes out a case of false representation, or perfidious dealing or unfair competition, but whether appellant had the exclusive right to use the word 'Elgin' as against all the world. Was it a lawfully registered trademark?"

Lawrence Mfg. Co. v. *Tenn. Mfg. Co.*, 138 U. S. 537.

What was said in *Chapman* v. *Goodnow*, 123 U. S. 540, 548, applies to the decision of the Court of Appeals of the District of Columbia in the Cancellation proceedings, and positively and conclusively answers appellant's claim:

"The Court did not refuse to give faith and credit to the (unfair trade) decree (in the Equity Action), but it acted upon a new cause of action with which the decree had no legal connection".

Third issue in the Equity Action.

To enjoin the R. S. Howard Company from further prosecuting the then pending cancellation proceedings to cancel the two trade-mark registrations involved at bar, "or any other application for the cancellation" of said registrations. Appellant prayed:

"3. That said defendant (R. S. Howard Company), its officers, attorneys, agents, servants, clerks, employees, workmen and confederates and all persons claiming through or under them and all in privity with them and each and every of them, may be perpetually restrained and enjoined by an order of this Honorable Court as follows:

* * *

(c) From prosecuting or causing to be prosecuted in the United States Patent Office the pending applications or any other applications for the cancellation of your orator's trade-mark 'Howard' for pianos, Certificates of Registration No. 31,411, dated March 8, 1898, and No. 46,993, dated October 17, 1905". (Cancellation Record p. 2607; Eq. Rec. p. 15, 16).

Both Courts, in the Equity Action in the Second Circuit, *although expressly urged, denied the injunction,* the District Court saying (Rec. p. 50):

"I am inclined to think if this Court has the power, it is inadvisable to seek to prevent the continuance of the cancellation proceedings in the Office.

"It is plain to me that the object of these proceedings is primarily to get rid of something which constitutes an obstacle to the extension into certain foreign countries (e. g. Cuba and Uraguay) of the business of the R. S. Howard Company".

This was directly responsive to the prayer for relief.

This respondent contends, as claimed in its motion to dismiss (Rec. p. 66), that said adjudication in said former Equity Action between the same parties *is res adjudicata of the injunction issue which is the only issue and the whole contention involved in the case at bar,* and that this controversy, now and here, should be terminated by a dismissal of the bill of complaint.

In the recent case of *United Shoe Mach. Co.* vs. *United States,* 258 U. S. 451, this Court, after quoting from the masterly opinion in *Cromwell* vs. *County of Sac,* 94 U. S. 351, 352, said (p. 459):

"In other words, to determine the effect of a former judgment pleaded as an estoppel, two questions must be answered: (1) Was the former judgment rendered on the same cause of action? (2) If not, was some

matter litigated in the former suit determinative of the matter in controversy in the second suit?"

Appellant's former Equity Action had for its object the identical purpose and the identical result which it now seeks here. All material allegations, every material fact, condition and circumstance, at bar, were pleaded in the former Equity action, and the only subject matter added here are the Court proceedings which have since occurred, all of which are immaterial; besides, all have been adverse to this appellant. The demand for an injunction was made in the former Equity Action, the same injunction both in substance and effect as is demanded at bar, and this demand was distinctly put in issue, adjudicated and determined in the former Equity Action and the injunction denied. It is respectfully submitted that such determination constitutes a complete estoppel and absolute bar to the present action.

But if the action at bar is not the same cause of action as was involved in the former Equity Action, it is most respectfully submitted that the same facts, the same subject-matter, the same circumstances, the same conditions, and the prayer for the same relief, both in substance and effect, were in *controversy,* were *litigated* and were *determined* in the former suit. The decision in the former action was essential to and "determinative" of the injunctive issue, which was "the matter in controversy"; it is also "determinative of the matter in controversy" in the action at bar, which is the injunctive issue. There is complete identity, "(1) Identity in the thing sued for; (2) Identity of the cause of action; (3) Identity of persons and parties to the action" (*Lyon* v. *Penn & Gaff Mfg. Co.,* 125 U. S. 698, 700); "identity of the thing demanded, the identity of the cause of the demand, and of the parties in the character in which they are litigants" (*Washington Packet Co.* v. *Sickles,* 24 How. 333, 341); "1. by a Court of competent jurisdiction upon the same subject-

matter; 2. between the same parties; 3. for the same purpose;" (*Aspden* v. *Nixon*, 4 How. 466, 498).

Cromwell vs. *County of Sac.*, 94 U. S. 351, 352, 353;
Fayerweather v. *Ritch*, 195 U. S. 277;
New Orleans v. *Citizens Bank*, 167 U. S. 371, 396.

The opinions of the Courts in said former Equity Action may be referred to for the purpose of showing what was actually decided. The opinions of both Courts are a part of the record at bar (Rec. pp. 44-54). *Courtney* v. *Pradt*, 196 U. S. 89; *Carson* v. *Three States Lumber* Co., 142 Fed. 893; 149 Fed. (C. C. A.) 377.

VII.

On Appeal, Even from an Interlocutory Order, this Court May Direct the Complaint to be Dismissed.

In the action at bar no appeal would lie to this Court from a decree on the merits (*Chott* v. *Ewing* 237 U. S. 197; *Durham* v. *Seymour, Commissioner* 161 U. S. 235) which was the situation in *Denver* v. *New York Trust Co.* 229 U. S. 123, 133. Under such a situation this Court may consider all the grounds of the motion to dismiss.

In *Denver* v. *New York Trust Co., supra,* the Court said:

> "We come, then, to the objections made to the orders granting temporary injunctions and as these objections are addressed, not merely to the injunction, but to the merits of both the bill and the cross-bill, it is well to observe at the outset that our power of review like that of Circuit Court of Appeals is not confined to the act of granting the injunctions, but extends as well to determining whether there is any insuperable objection, in point of jurisdiction or merits, to the maintenance of

either bill, and if so, to directing a final decree dismissing it. *Smith* v. *Vulcan Iron Works,* 165 U. S. 518, 525; *Mass. Foos & Co.* v. *Stover Manufacturing Co.,* 177 U. S. 485, 494; *Harriman* v. *Northern Securities Co.,* 197 U. S. 244, 287; *United States Fidelity & Guaranty Co.* v. *Bray,* 225 U. S. 205, 214."

If it is apparent from the record that the injunction sought must be denied, the decree below dismissing the Complaint should be affirmed. (*Beasley* v. *Texas & Pac. Rwy Co.,* 191 U. S. 492, 498).

If this Court differs from the Court below on the question of jurisdiction, the failure of the Court below to consider the other grounds of the motion to dismiss the Complaint presents no reason why this Court should not consider the other grounds. (*Billings* v. *United States,* 232 U. S. 261, 276, 277; *McGowan* v. *Parish,* 237 U. S. 285, 291, 292; *Cole* v. *Ralph,* 252 U. S. 286).

VIII.

Whether or not the R. S. Howard Company is Damaged by the Registrations at Bar is Wholly Immaterial.

The Complaint, at bar, alleges that the R. S. Howard Company is not and cannot be damaged by said registrations and this is a reason alleged by appellant why the Cancellation Action should be re-tried under Sec. 4915 R. S.

It is respectfully submitted that whether or not the R. S. Howard Company is or may be damaged is wholly immaterial.

Unless the R. S. Howard Company's claim of damage in the Cancellation proceedings was frivolous, or a pretense, it gave the Court of Appeals of the District of Columbia juris-

diction; that it was not frivolous or a pretense is obvious on the face of the pleadings and decree.

The Fair v. *Kohler Die & Specialty Co.*, 228 U. S. 22, 24, 25;
Healy v. *Sea Gull Specialty Co.*, 237 U. S. 479.

If the Cancellation Action was an administrative proceeding and there was some evidence to support the decision, a decision "based upon some evidence to that effect would be conclusive and final, and not subject of review by any Court." (*School of Magnetic Healing* v. *McAnnulty*, 187 U. S. 94, 109.

It was not necessary for the R. S. Howard Company to establish damage; it was sufficient to show *probable* interference with its trade or business, or "to be likely to cause confusion or mistake in the mind of the public or to deceive purchasers." Both Trade-Mark Acts (Secs. 2, 3 and 5), by their terms, look to the future as well as the past.

However, if it be held that whether or not the R. S. Howard Company is or can be damaged by said registrations is material, it is respectfully submitted that it not only affirmatively appears in the Record that this fact has been adjudicated between the parties and fully established, but also that it affirmatively appears on the face of the Record, as a matter of law and fact.

Grounds of Damages to R. S. Howard Co.

The elements or grounds of injury and damage to the R. S. Howard Company may be summarized under the following six heads:

1. The Record shows that The Baldwin Company admits sending threatening and intimidating letters to respondent's customers, claiming rights under trade-marks "duly regis-

tered by us in the United States Patent Office," and "will take all necessary steps to protect our rights against infringement." Samples of these threatening and intimidating letters are set out in the Record pp. 43, 44, although no justifiable claim could be made that respondent was using appellant's style of lettering.

It is respectfully submitted that any use by The Baldwin Company of unlawful registrations which threatens damage is a continuing menace, injury and damage to respondent; that the direct and obvious purpose of the letters was to intimidate respondent's customers, threaten them with litigation, and cause them to cease to deal in respondent's pianos.

American Wells Works Co. v. *Layne & Bowler Co.*, 241 U. S. 257;

Panay Shaw Jar Co. v. *Oridor*, 292 Fed. (C. C. A.) 858, 859;

Racine Paper Goods Co. v. *Dittgen*, 171 Fed. (C. C. A.) 631;

Kidd v. *Horry*, 28 Fed. 773 (Mr. Justice Bradley);

Seattle Brewing Co. v. *Hansen*, 144 Fed. 1011 and cases cited.

2. The Baldwin Company's suit and threatened suits against respondent and respondent's customers for infringement of said registrations constitute a continuing threat of serious and permanent damage to respondent's business and an intimidation of its customers. The Trade-Mark statutes look to the future.

"The registration is itself a standing threat". *Denny Tag Co.* v. *Dennison Mfg. Co.*, 256 O. G. 221; aff. 48 App. D. C. 213.

Elgin Nat'l Watch Co. v. *Illinois Watchcase Co.*, 179 U. S. 665.

Suing or threatening to sue has been repeatedly held to be "injury" and "damage".

International Bedding Co. v. *Ostermoor & Co.*, (Feb. 13, 1923) 319 O. G. 235;
Familton v. *Alonzo Bliss Co.*, 1908 C. D. 189;
Hydraulic Brick Co. v. *Hocking Valley Products Co.*, 120 Ms. Dec. 196;
Needham Tire Co. v. *Hood Rubber Co.*, 124 Ms. Dec. 396.

If appellant's registrations are allowed to remain, it would give appellant opportunity to stir up litigation which is positively contrary not only to the purpose and spirit of equity but also to the statutory provisions of the Trade-Mark Acts.

Old Lexington Club D. Co. v. *Kentucky D. & W. Co.*, 234 Fed. 464, 469; aff. on Opinion below 247 Fed. 1005;
Crown Die & Tool Co. v. *Nye Tool Co.*, 202 U. S. 453, 458;
Electro Steel Co. v. *Lindenburg Steel Co.*, 43 App. D. C. 270.

If appellant's contentions at bar prevail, it would mean that by prostituting the forms of law it may obtain a record bearing the authority of the Government of the United States which can be used to respondent's damage and injury particularly in foreign countries.

To permit said registrations to remain of record is equivalent to ruling that The Baldwin Company has the *exclusive right* to the personal name "Howard" (*McIlhenny Sons* v. *Trappey*, 278 Fed. 562), and would, in substance, give to the personal name "Howard" "the full effect of a trade-mark while denying its validity as such", for a claim to a registered trade-mark is a claim "to appropriate the exclusive use of the term" (*Standard Paint Co.* v. *Trinidad Asphalt Co.*, 220 U. S., 446) either with or without accessory symbols or words. (*Thad Davids Co.* v. *Davids*, 233 U. S. 461

Walter Baker & Co. v. *Delapenha,* 160 Fed. 746, 750, and cases cited).

3. Respondent has been adjudged entitled to use "R. S. Howard Co." as its business and corporate name and so to mark its pianos (Rec. p. 5).

Pianos bearing the name "Howard" or any name of which the name "Howard" formed a part, have always been called "Howard" pianos by everybody, because "Howard" was the dominant feature of the name on the pianos. Prefixes and suffixes are entirely disregarded by the trade and public generally. (Judge Hough's opinion, Rec. p. 47); Mr. Steinway's testimony, Rec. p. 27; Mr. Dickinson's testimony, Rec. p. 34.)

> "It is the surname which catches the public, and few purchasers would notice the difference between one form and the other. In the nature of things confusion was inevitable." "Guth Chocolate Company" held to be an infringement and colorable imitation of "Guth". *Guth* vs. *Guth Chocolate Co.*, 224 Fed. (C. C. A.) 932.

"C. I. Davids Co.." and "Davids Mfg. Co." were held by this Court to be infringements of the registered mark "Davids", registered under the "ten-year" clause. This Court said:

> "The use of the name in this manner was a mere simulation of the complainant's mark which it duly registered; it constituted a 'colorable imitation' within the meaning of the Act. * * * We agree with the Circuit Court that infringement is shown". *Thad. Davids Co.* v. *Davids,* 233 U. S. 461, 469.

"William P. Stark Nurseries" held to infringe the registered trade-mark "Stark Trees". *William P. Stark* vs. *Stark Bros.*, 257 Fed. (C. C. A.) 9.

"Tucker" and "J. C. Tucker" held similar and confusing. *Brown-Forman Co.* v. *Beech Hill Dist. Co.*, 30 App. D. C. 485.

"Taylor", "Old Taylor", "G. A. Taylor", "Kentucky Taylor", are all held to be similar and confusing. *In re Wright*, 33 App. D. C. 510.

"Hoff" and "Leopold Hoff" held so similar as to create confusion. *In re Hoff*, 30 App. D. C. 233.

4. Said registrations being *prima facie* evidence of *exclusive* ownership of a *valid trade-mark* of the personal name "Howard", The Baldwin Company would *prima facie* be entitled to the exclusive use of "Howard" *in any form, and in every form*, whether used with or without prefixes or suffixes.

Thad. Davids Co. v. *Davids*, 233 U. S. 461;

Shredded Wheat Co. v. *Humphrey Cornell Co.*, 250 Fed. (C. C. A.) 960;

Elgin Nat'l Watch Co. v. *Illinois Watchcase Co.*, 179 U. S. 665.

5. Respondent is damaged by the registration of the personal name "Howard", the dominant feature of its corporate name.

As the Baldwin Company has no exclusive right to the personal name "Howard", damage and injury to respondent is implied and presumed, as a matter of law, by the improper registration of the dominant and distinguishing feature of respondent's corporate name. Respondent was incorporated in 1902, appellant did not make statutory use of "Howard" prior to 1912. (Sargent's testimony Rec. pp. 31, 32).

Mansfield Tire & Rubber Co. v. *Ford Motor Co.*, 44 App. D. C. 205;

Investor Pub. Co. v. *Dobinson*, 72 Fed. 603, 606, and cases cited.

6. Respondent is irreparably damaged in its foreign business by The Baldwin Company's foreign registrations of "Howard" which foreign registrations The Baldwin Company admits in its complaint (Rec. p. 8, par. 11) it has regis-

tered, basing such foreign registrations in some fifteen foreign countries on certified copies of said Registration No. 46,993 (Donegan's testimony, Rec. p. 30).

In refusing the injunction (same as now sought) in the former Equity Action between appellant and respondent, the Court said (Rec. p. 50):

> "It is plain to me that the object of these (Cancellation) proceedings is primarily to get rid of something which constitutes an obstacle to the extension into certain foreign countries (e. g. Cuba and Uruguay) of the business of the R. S. Howard Company."

The Record shows, without contradiction, that respondent since 1902 has been doing an extensive foreign business in a long list of foreign countries (Marken's testimony, Rec. p. 26; Stower's testimony, Rec. p. 26; Barber's testimony, Rec. p. 28). The undisputed testimony is that in most, if not all, Spanish speaking and South American countries infringement of a registered trade-mark is a criminal and penal offense, subjecting dealers to the penalty of fine and imprisonment and the goods bearing the infringing mark to confiscation (Stower's testimony, Rec. p. 26; Barber's testimony, Rec. p. 28); that in Spanish speaking countries the distinction between a trade-mark and a trade-name is not understood or not recognized; that this same confusion and failure to distinguish between a trade-mark and a trade-name is found in all countries; that "the timidity of dealers in the handling of goods, the trade-name or trade-mark on which is questioned, or is the subject of dispute, is very well recognized in all countries"; that in Spanish speaking and South American countries what may be considered a "similar" marking is quite indefinite and undeterminable, but that any mark bearing any dominant feature of a registered mark would probably be considered "similar" and an infringement, with little hope of securing from any Court the right to sell under a business or trade-name which in any degree bore resemblance to a registered trade-mark. (Barber's testimony, Rec. pp. 27-30).

There is no practical dsitinction between Trade-Marks and Trade-Names.

The distinction pointed out in some American and English decisions between a trade-name and a trade-mark is not generally recognized by dealers, the public or even by the Courts; even the American and English Court decisions are full of such confusion.

> "The terms 'trade-mark', 'trade-name' and 'technical trade-mark' are confused constantly, both in Court opinions and in the public press. This confusion is natural, and arises out of the manner in which the law of trade-marks has been developed in English and American jurisprudence * * * Much confusion exists due to the loose use to which it (the term 'Trade-mark') is constantly put in legal literature." *Nims, on Unfair Competition and Trade-Marks,* pp. 372-5 (2nd Ed).

IX.

The Decree Below Should be Affirmed on the Ground that, in Trade-Mark Cancellation Proceedings, Congress has made the Review by the Court of Appeals of the District of Columbia the Exclusive and Final Remedy; that Sec. 4915 R. S. does not Authorize the Action at Bar, and, even if it did, that this Action was not Brought Within the Statutory time;

or

The Decree Below Should be Affirmed on the Ground that Appellant's Claim is so Unsubstantial as to be Without Color of Merit.

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